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**UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION**

FINJAN LLC, a Delaware Corporation,

Plaintiff,

v.

SONICWALL, INC., a Delaware Corporation,

Defendant.

Case No.: 5:17-cv-04467-BLF (VKD)

**STIPULATION AND [PROPOSED] ORDER
RE: SUBMISSION OF BRIEFS RELATING
TO COLLATERAL ESTOPPEL ISSUES FOR
THE '844, '780, AND '494 PATENTS**

Judge: Hon. Beth Labson Freeman
Dept: Courtroom 3, Fifth Floor

1 Plaintiff Finjan, LLC (“Finjan”) and Defendant SonicWall, Inc. (“SonicWall”)
2 (collectively, the “Parties”), respectfully submit this Stipulation and [Proposed] Order Re:
3 Submission of Briefs Relating to Collateral Estoppel Issues for the ’844, ’780, and ’494 Patents.

4 WHEREAS, in the matter of *Finjan, LLC v. Cisco Systems, Inc.*, No. 5:17-cv-00072-BLF-
5 SVK (N.D. Cal.) (“Cisco Action”), Cisco Systems, Inc. (“Cisco”) and Finjan filed the following
6 motion and briefs: Cisco’s Motion for Judgment of Invalidity of the ’844, ’780, and ’494 Patents
7 Based on Collateral Estoppel (Dkt. No. 759) (attached hereto as Ex. A); Finjan’s Opposition to
8 Cisco’s Motion for Judgment of Invalidity of the ’844, ’780, and ’494 Patents Based on Collateral
9 Estoppel (Dkt. No. 762) (attached hereto as Ex. B); and Cisco’s Reply in Support of its Motion for
10 Judgment of Invalidity of the ’844, ’780, and ’494 Patents Based on Collateral Estoppel (Dkt. No.
11 764) (attached hereto as Ex. C) (collectively “Collateral Estoppel Briefs”).

12 WHEREAS, the Parties respectfully request that the Collateral Estoppel Briefs filed in the
13 Cisco Action be deemed filed in this case.

14 WHEREAS, the Parties further request that Cisco’s motion and reply brief (Exs. A and C
15 hereto) and the relief requested therein be deemed filed by SonicWall in this case and Finjan’s
16 opposition (Ex. B hereto) be deemed filed by Finjan in this case.

17 WHEREAS, with the Collateral Estoppel Briefs deemed as filed in this case, the Parties
18 respectfully submit that the Motion for Judgment of Invalidity of the ’844, ’780, and ’494 Patents
19 Based on Collateral Estoppel is ripe in this case and ready for resolution by the Court.

20 NOW, THEREFORE, the Parties respectfully request that the Court issue the proposed
21 order consistent with the above jointly submitted herewith.

1 Dated: June 21, 2021

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CONCURRENCE IN FILING

I, Matthew C. Gaudet, hereby attest that the concurrence to the filing of this document has been obtained from each signatory hereto.

/s/ Matthew C. Gaudet
Matthew C. Gaudet

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the above and foregoing document has been served on June 21, 2021, to all counsel of record who are deemed to have consented to electronic service via the Court's CM/ECF system.

/s/ Matthew C. Gaudet
Matthew C. Gaudet

EXHIBIT A

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10 UNITED STATES DISTRICT COURT
11 NORTHERN DISTRICT OF CALIFORNIA,
12 (SAN JOSE DIVISION)

13 FINJAN LLC, a Delaware Limited Liability
14 Company,

15 Plaintiff,

16 „

17 CISCO SYSTEMS, INC., a California
18 Corporation,

19 Defendant.

Case No. 5:17-cv-00072-BLF-SVK

**CISCO SYSTEMS, INC.’S MOTION FOR
JUDGMENT OF INVALIDITY OF THE
‘844, ‘780, AND ‘494 PATENTS BASED
ON COLLATERAL ESTOPPEL**

Defendant Cisco Systems, Inc. (“Cisco”) seeks judgment that the ’844 and ’780 Patents are invalid based on the ESET Order and that the ’494 Patent is invalid based on the same “issue” resolved against Finjan in the ESET Order. For the ’494 Patent, Federal Circuit law is clear that the ESET Order applies with equal force to patents whose intrinsic record presents the same “issue” that led to the invalidity ruling. The ’494 Patent satisfies this test because it is a continuation of a patent found invalid in the ESET Order (the ’086 Patent), with the same “Downloadable” term, the same specification, and the same intrinsic record on which the ESET Order relied (in fact, the same intrinsic record on which the ESET Order relied to invalidate all five related patents). Based on the reasoning of the ESET Order and the collective treatment of those five patents, the ’494 Patent unquestionably would have been found invalid in that case had Finjan asserted it there. The Federal Circuit case law confirms that this is a distinction without a difference; the patent holder is estopped with respect to all patents that present the same “issue.” The law is equally clear that Cisco’s prior positions in this case do not protect Finjan from the impact of the ESET Order on the ’494 Patent. Collateral estoppel renders the ’494 Patent invalid, regardless of what has previously occurred in this case.

I. BACKGROUND

On March 23, 2021, Judge Bencivengo issued a summary judgment order invalidating the ’844 and ’780 Patents, along with U.S. Patent Nos. 8,079,086 (“’086 Patent”); 9,189,621 (“’621 Patent”); and 9,219,755 (“’755 Patent”) (collectively, “Invalidated Patents”), as indefinite based on the term “Downloadable.” *Finjan, Inc. v. ESET, LLC*, Case No. 3:17-cv-0183-CAB-BGS, Dkt. No. 864 (“ESET Order,” attached as Ex. A) at 8. Judge Bencivengo based her decision on her construction of “Downloadable” as “a small executable or interpretable application program which is downloaded from a source computer and run on a destination computer,” which is the express definition set forth in U.S. Patent Nos. 6,167,520 (“’520 Patent”) and 6,480,962 (“’962 Patent”) that the Invalidated Patents incorporate by reference. *Id.* at 4-5.

The ’494 Patent is a direct continuation (with the identical specification) of the ’086 Patent, which the ESET Order invalidated. Dkt. No. 1-5 (’494 Patent) at 1:7-11. Every claim of the ’494 Patent contains the now-indefinite term “Downloadable.” Just like each of the

Invalidated Patents, the '494 Patent incorporates by reference the subject matter of the '520 and '962 Patents that served the basis of the ESET Court's indefiniteness decision. *Id.* at 1:43-55.

II. GOVERNING LAW FOR COLLATERAL ESTOPPEL

"To foreclose relitigation of an issue under collateral estoppel, four conditions must be met: '(1) the issue at stake was identical in both proceedings; (2) the issue was actually litigated and decided in the prior proceedings; (3) there was a full and fair opportunity to litigate the issue; and (4) the issue was necessary to decide the merits.'" *Arista Networks, Inc. v. Cisco Sys., Inc.*, No. 16-CV-00923-BLF, 2017 WL 6102804, at *11 (N.D. Cal. 10/10/17) (quoting *Oyeniran v. Holder*, 672 F.3d 800, 806 (9th Cir. 2012)). Under Ninth Circuit law, a summary judgment order satisfies the requirement of a "final judgment" for the purpose of collateral estoppel, regardless of whether it is appealable yet. *Abbott Diabetes Care Inc. v. Roche Diagnostics Corp.*, C04-02123MJJ, 2007 WL 1239220, at *12 (N.D. Cal. 4/27/07) ("Under Ninth Circuit law, to be 'final' for collateral estoppel purposes, a decision need not possess 'finality' in the sense of 28 U.S.C. § 1291. Instead, a final judgment for purposes of collateral estoppel is any prior adjudication of an issue in another action that is determined to be 'sufficiently firm' to be accorded preclusive effect." (internal citations omitted)). Even "the pendency of an appeal in the Federal Circuit 'does not suspend the operation of an otherwise final judgment as *res judicata* or collateral estoppel.'" *Gonzalez v. Tagged, Inc.*, 16-cv-00574-YGR, 2016 WL 3257734, at *2 (N.D. Cal. 6/14/16) (quoting *Convergence Corp. v. Videomedia*, 539 F. Supp. 760, 762 (N.D. Cal. 1981)).

III. THE '844 AND '780 PATENTS ARE INVALID

The ESET Order satisfies the four elements for collateral estoppel for the '844 and '780 Patents and already qualifies as a "final judgment" for purposes of collateral estoppel. *Id.* This Court therefore should enter judgment of invalidity.

IV. THE '494 PATENT IS ALSO INVALID

The ESET Order also satisfies the four collateral estoppel elements for "Downloadable" in the '494 Patent. The first element ("identical issue") is met for the reasons discussed below. The ESET Order on its face confirms the last three elements: the issue (whether the claim term "Downloadable" is indefinite on this intrinsic record) was litigated and decided in the ESET

Order; Finjan had a “full and fair opportunity” to litigate it; and the issue was necessary to decide the merits of invalidity. Finjan’s arguments about why it disagrees with the ESET Order are irrelevant; the “full and fair opportunity” prong is a limited inquiry. *Stevenson v. Sears, Roebuck & Co.*, 713 F.2d 705, 709 (Fed. Cir. 1983) (“it is clear from the case law that has developed since *Blonder-Tongue* that an inappropriate inquiry is whether the prior finding of invalidity was correct; instead, the court is only to decide whether the patentee had a full and fair opportunity to litigate the validity of his patent in the prior unsuccessful suit”).

A. The ‘494 Patent Is Invalid Based on the “Identical Issue” as the ESET Order

Although the ‘494 Patent is not referenced in the ESET Order (because it was not asserted against ESET), the same indefinite term (“Downloadable”) appears in every claim of the ‘494 Patent, and the ‘494 Patent has the same intrinsic record on which the ESET Order relied. In other words, every basis for the ESET Order exists and applies with equal force to the ‘494 Patent. To bring this issue into clear focus, if Finjan had asserted the ‘494 Patent in the ESET case, the ESET Order already would have held the ‘494 Patent invalid.

The *Blonder-Tongue* principle therefore applies equally to the ‘494 Patent. *Ohio Willow Wood Co. v. Alps S., LLC*, 735 F.3d 1333, 1342 (Fed. Cir. 2013) (“Our precedent does not limit collateral estoppel to patent claims that are identical. Rather, it is the identity of the *issues* that were litigated that determines whether collateral estoppel should apply.”). In cases applying the “same issue” principle from *Ohio Willow*, the Federal Circuit has used collateral estoppel to invalidate a related patent (i.e., a *different* patent than the patent on which collateral estoppel arises) as a matter of law, where the “issue” was the same -- and the Federal Circuit did so even where the issue was raised for the first time on appeal:

It is undisputed that the claims at issue in the two appeals use the term “aseptic” (or its related variation “aseptically disinfecting”) in a similar fashion. *Compare* ‘468 patent, col. 26 l. 20 . . . with ‘013 patent, col. 16 ll. 36-62 More critically, the two patents also provide identical lexicography for the term ‘aseptic’ in their specifications... Neither party has pointed to any material difference between the two patents or their prosecution histories that would give rise to claim construction issues in this appeal different from

those raised in the prior appeal. Accordingly, Steuben Foods has had a full and fair opportunity to litigate the issue of claim construction during the prior appeal. *Nestlé USA, Inc. v. Steuben Foods, Inc.*, 884 F.3d 1350, 1351-52 (Fed. Cir. 2018). *See also Papst Licensing GMBH & Co. v. Samsung Elecs. Am., Inc.*, 924 F.3d 1243, 1252-53 (Fed. Cir. 2019) (“The ’144 Patent Aytac Decision resolved against Papst the claim construction and Aytac-teaching issues now before us [on the ’437 Patent], and those resolutions were essential to the Board's decision. . . . Issue preclusion therefore applies”)

Any difference in surrounding claim language is irrelevant; it is the identity of the “issue” (i.e., whether the term “Downloadable” is indefinite based on the ESET Court’s claim construction) that is controlling. *Arunachalam v. Presidio Bank*, 801 F. App’x 750, 752-53 (Fed. Cir. 2020) (“As to the first condition for applying collateral estoppel (identical issue), we find that the remaining claims in the ’500, ’492, and ’158 patents all rely on at least one of the claim terms found indefinite, not enabled, or failing written description by *JPMorgan* and that these remaining claims do not significantly alter the analysis of those terms.”).

B. The Details of the Earlier Proceedings In This Case Are Irrelevant

Finjan seeks to avoid the application of collateral estoppel to the ’494 Patent based on Cisco’s stipulation to a different construction of the term “Downloadable” in this case, but that stipulation is no more relevant to the invalidity of the ’494 Patent than it is to the ’844 and ’780 Patents. In applying collateral estoppel in this context, a court simply determines whether the 4-factor test is met, and does not revisit whether it agrees with the other court’s ultimate decision on invalidity or the sub-issues that led to the invalidity finding. *Crossroads Sys. (Tex.), Inc. v. Dot Hill Sys. Corp.*, 2006 WL 1544621, at *5 (W.D. Tex. 5/31/06) (“the overwhelming weight of authority suggests that the ‘issue’ that is to be given issue-preclusive effect to a judgment in the patent context is the ultimate determination on patent validity itself, not the sub-issues or the individual pieces of evidence and arguments that may have been necessary to support the validity determination”). Under *Ohio Willow*, the “issue” for all three patents is the same, i.e., the invalidity of the patents arising from the indefiniteness of the term “Downloadable” based on the same intrinsic record. Just like the ’844 and ’780 Patents, the earlier stipulation in this case on the

'994 Patent is legally irrelevant. Indeed, the doctrine would apply even if Cisco had previously lost the issue of validity at trial. *Mendenhall v. Barber-Greene Co.*, 26 F.3d 1573, 1579-80 Fed. Cir. 1994).

Cisco's stipulation on the underlying issue of the construction of "Downloadable" cannot change the outcome that the '994 Patent is now invalid. Regardless of what happened earlier in this case, the doctrine of collateral estoppel does not allow the '994 Patent to be invalid when asserted against the rest of the world, but still valid against Cisco. Indeed, in *Mendenhall*, the Federal Circuit reversed a district court's refusal to apply collateral estoppel where the defendant seeking to apply the invalidity ruling from another case (i.e., the party situated like Cisco here) had itself *already tried and lost* the issue of invalidity, and then after that trial a different court found the patent to be invalid:

[O]ur precedent holds that the defense of collateral estoppel based on a final judgment of patent invalidity in another suit can "be timely made at any stage of the affected proceedings." . . . [A]ppellants' defense of collateral estoppel is not untimely.

Id. at 1579-80. A district court has rejected the materially identical argument that Finjan makes:

Quest also contends that collateral estoppel should not apply because A.Hak has stipulated to definitions of certain claim terms that are different than the constructions applied by Judge Robinson. That, however, is an issue of claim construction that does not alter the preclusive effect of Judge Robinson's express findings that specific patent claims at issue in this action are invalid. The Court finds that collateral estoppel applies

Quest Integrity USA, LLC v. A.Hak Indus. Servs. US, LLC, No. C14-1971-RAJ, 2017 U.S. Dist. LEXIS 119821, at *10-11 (W.D. Wash. 7/31/17), *vacated on other grounds by agreement of the parties*, 2:14-cv-01971 RAJ, 2019 U.S. Dist. LEXIS 79571, at *1 (W.D. Wash. 5/10/19). The Federal Circuit has likewise repeatedly held that a defense of collateral estoppel based on a final judgment of patent invalidity in another suit can "be timely made at any stage of the affected proceedings." *Dana Corp. v. NOK, Inc.*, 882 F.2d 505, 507 (Fed. Cir. 1989). *See also Thompson-Hayward Chem. Co. v. Rohm & Hass Co.*, 745 F.2d 27, 32-33 (Fed. Cir. 1984) (applying estoppel to invalidity judgment on appeal even though infringer did not challenge validity at trial).

1 Dated: April 19, 2021

Respectfully Submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the above and foregoing document has been served on April 19, 2021 to all counsel of record who are deemed to have consented to electronic service via the Court's CM/ECF system.

/s/ Nicole E. Grigg
Nicole E. Grigg

[PROPOSED] ORDER

Upon consideration of all pleadings, papers, and arguments submitted in support of and opposition to Defendant Cisco Systems, Inc.’s Motion for Judgment of Invalidity of the ’844, ’780, and ’494 Patents Based on Collateral Estoppel (“Cisco’s Motion”), and good cause appearing therefor, the Court hereby GRANTS Cisco’s Motion and enters judgment that the ’844, ’780, and ’494 Patents are invalid for the reasons set forth in Cisco’s Motion.

Dated: _____

Hon. Beth Labson Freeman
United States District Court Judge

Exhibit A

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA

FINJAN, INC.,

Plaintiff,

v.

ESET, LLC, a California Limited Liability
and ESET SPOL. S.R.O., a Slovak
Republic Corporation,

Defendants.

Case No.: 3:17-cv-0183-CAB-BGS

**ORDER ON DEFENDANTS’
RENEWED MOTION FOR
SUMMARY JUDGMENT OF
INDEFINITENESS
[Doc. No. 806]**

Before the Court is the renewed motion of Defendants ESET, LLC and ESET spol. s.r.o (collectively “ESET”) for summary judgment to invalidate Plaintiff Finjan’s United States Patent Nos. 6,154,844; 6,804,780; 8,079,086; 9,189,621; and 9,219,755 (“the patents at-issue”) as indefinite pursuant to 35 U.S.C. § 112 based on this Court’s construction of the claim term “Downloadable.” The motion is fully briefed, and the Court deems it suitable for submission without oral argument.

I. Background

This motion has an unusual history. ESET filed a motion for summary judgment asserting that the patents at-issue are indefinite at the close of fact discovery in this case, and the Court held argument on September 26, 2019. Finding that there were factual disputes regarding what a skilled artisan in 1997 would have understood constituted a

1 “Downloadable” based on the Court’s construction of that term, the Court denied the
2 motion without prejudice. [Doc. No. 699.] It was anticipated that trial testimony would
3 establish what was generally understood in the art in 1997 as a “Downloadable” and such
4 testimony would inform the scope of infringement. [Doc. No. 697, at 22:3-15.]

5 A jury trial commenced in this case on March 10, 2020. After three trial days the
6 Court was forced to vacate the remainder of the trial, excuse the jury and declare a mistrial
7 due to the COVID-19 pandemic and the issuance of the State of California’s stay-home
8 order. [Doc. No. 783.] This District’s continuing moratorium on civil jury trials and
9 backlog of criminal jury trials currently precludes scheduling a new trial in this matter.

10 Having heard testimony from Finjan’s expert during the vacated trial on this issue,
11 however, the Court permitted ESET to renew this motion in consideration of the testimony
12 that was taken. Although Finjan’s patents have been the subject of much litigation, and
13 the term “Downloadable” has been construed by other courts, the issue raised in ESET’s
14 current motion does not appear to have been addressed by any prior constructions.

15 Finjan is the owner of a large family tree of patents for security systems and methods
16 of detecting malware in computer programs. Finjan has litigated many of their patents,
17 including some of the patents at-issue in this motion, in other district courts. Many have
18 also been subject to *inter partes* review by the Patent and Trademark Office (PTO). The
19 Federal Circuit has issued at least nine opinions, precedential and non-precedential, on
20 appeals from district courts and the PTO regarding Finjan patents. Yet none of these orders
21 or opinions discuss how earlier references incorporated into the patents at-issue inform the
22 construction of the term “Downloadable.”

23 **II. The Construction of “Downloadable”**

24 In 2017, Finjan filed this litigation against defendants ESET asserting infringement
25 of the patents at-issue, and United States Patent No. 7,975,305.¹ Finjan claims priority for
26

27
28 ¹ The ‘305 patent is not subject to this motion as it does not include the claim term “Downloadable.”

the patents at-issue back to an application filed on November 8, 1996, Provisional Application 60/030639. [Doc. No. 139-24.] The application is directed at “a system and method for protecting computers from hostile Downloadables,” described as executable application programs automatically downloaded from a source computer and run on the destination computer that might carry computer “viruses.” [Id., at 5-6.] The claim term “Downloadable” is presented as a capitalized term in the provisional application and all the patents at-issue, signaling it is a specifically defined term. The definition of “Downloadables,” however, is not consistent throughout Finjan’s subsequently issued patents. The explicit definitions include:

- “applets” (little applications) described in the 1990s as small interpreted or executable programs. *See* Provisional Application 60/030639 (filed November 8, 1996) [*Id.* at 5-6.]
- “Downloadables (i.e., applets)” as “a small executable or interpretable application program which is downloaded from a source computer and run on a destination computer,” in conformity with the original provisional application. *See* U.S. Patent No. 6,167,520, at Col. 1:31-34 (application filed January 29, 1997); U.S. Patent No. 6,480,962, at Col. 1:38-41 (filed April 18, 2000).
- “an executable application program which is downloaded from a source computer and run on a destination computer” (without “i.e., applet,” “small” or “interpretable” included in the definition but using applets and interpretable programs as examples of a “Downloadable” and incorporating the earlier definition by reference). *See* U.S. Patent No. 6,092,194, at Col. 1:44-55 (filed November 6, 1997); U.S. Patent No. 6,804,780 at Col. 1:50-60 (filed March 30, 2000).

Other district courts have determined that “Downloadable” lacked ordinary meaning when the patents were filed and construed it as “an executable application program which is downloaded from a source computer and run on a destination computer,” applying the

1 explicit definition from the ‘194 patent. [Doc. No. 139-10, at 3; Doc. No. 138-4, at 2-5 (the
2 term was not amenable to plain and ordinary meaning and the patent applicant intended to
3 act as the lexicographer of this term, therefore the specification definition controls).] None
4 of these orders, however, discussed the significance of the ‘520 patent’s definition
5 incorporated into the ‘194 patent and its continuations. One district court, without
6 explanation, applied the broader definition from the ‘194 patent specification to the
7 construction of the term “Downloadable” in the ‘962 patent as “the same” definition [id.,
8 at 3, fn. 4], disregarding the fact the ‘962 patent explicitly defines “Downloadable” as “a
9 *small* executable or interpretable application program which is downloaded from a source
10 computer and run on a destination computer.” See U.S. Patent No. 6,480,962, at Col. 1:39-
11 41 (*emphasis* added).

12 Incorporation by reference provides a method for integrating material from various
13 documents into a host document by citing such material in a manner that makes clear that
14 the material is effectively part of the host document as if it were explicitly contained
15 therein. See *Trustees of Columbia Univ. v. Symantec*, 811 F.3d 1359, 1365-66 (Fed. Cir.
16 2016) (*citing Advanced Display Sys. v. Kent State Univ.*, 212 F.3d 1272, 1282 (Fed. Cir.
17 2000) (provisional applications incorporated by reference are effectively part of the
18 specification as though it was explicitly contained therein.)). By incorporating the earlier
19 definition of “Downloadable” from the ‘520 Patent into the ‘194 Patent and subsequent
20 continuations (including the patents at-issue), the scope of the term is limited to “*small*
21 executable or interpretable application programs,” and not *all* executable application
22 programs (*emphasis* added). See *Symantec*, 811 F.3d at 1365 (rejecting a broad
23 interpretation of a claim term in part because a provisional application incorporated by
24 reference the same term more narrowly defined.) Inconsistent language used later cannot
25 support a broad claim construction when the explicit definition is incorporated from earlier
26 patents in the family tree.

27 In this case, the Court concluded that based on its incorporation by reference in all
28 the patents at-issue, the explicit definition of “Downloadables” from the ‘520 patent and

1 the '962 patent, which is supported by the examples provided in the specification, is the
2 proper construction of “Downloadables” – “a small executable or interpretable application
3 program which is downloaded from a source computer and run on a destination computer.”
4 [Doc. No. 195.]

5 **III. The Indefiniteness Determination**

6 The Court’s claim construction, not unexpectedly, resulted in the present dispute as
7 to the scope of the modifier “small.” ESET argues that “small” is a term of degree with
8 not technical meaning or defined boundaries and there is insufficient information in the
9 intrinsic record for a skilled artisan to have clear notice of what constitutes a “small
10 executable or interpretable application program.” They further argue that this is
11 demonstrated by the inability of Finjan’s experts to come to a consistent opinion as to what
12 objective boundaries constitute a small application program. [806-1, at 5, 17.]

13 The definiteness requirement of paragraph 2 of 35 U.S.C. §112 requires that the
14 “specification shall conclude with one or more claims particularly pointing out and
15 distinctly claiming the subject matter which the applicant regards as his invention.” The
16 definiteness requirement focuses on whether “a patent’s claims, viewed in light of the
17 specification and prosecution history inform those skilled in the art about the scope of the
18 invention with reasonable certainty.” *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S.
19 898, 910 (2014). The inquiry “trains on the understanding of a skilled artisan at the time
20 of the patent application.” *Id.* at 911.

21 Terms of degree must provide sufficient certainty to one of skill in the art to afford
22 clear notice of what is claimed and what is still open to the public. *See Biosig Instruments,*
23 *Inc. v. Nautilus, Inc.*, 738 F.3d 1374, 1378 (Fed. Cir. 2015) (“When a ‘word of degree’ is
24 used, the court must determine whether the patent provides ‘some standard for measuring
25 that degree.’”); *Interval Licensing LLC v. AOL, Inc.*, 766 F.3d 1364, 1370 (Fed. Cir. 2014)
26 (the definiteness standard must allow for a modicum of uncertainty but must also require
27 clear notice of what is claimed thereby apprising the public of what is still open to them).
28

1 Finjan’s contention that the claim term “Downloadable” cannot be indefinite simply
2 because the Court was able to construe it by adopting the explicit definition provided by
3 the inventor in the ‘520 patent fails to address the issue raised by ESET. A defined term is
4 still indefinite if a person of ordinary skill in the art cannot translate the definition into
5 meaningfully precise claim scope. *Halliburton Energy Servs., Inc. v. M-I LLC*, 514 F.3d
6 1244, 1251 (Fed. Cir. 2008). The issue therefore is whether a skilled artisan in 1997 would
7 have understood with reasonable certainty based on the specification and prosecution
8 history what the inventor meant by a “small” application program and therefore understood
9 what comes within the scope of the claims.

10 The ‘510 patent, incorporated into all the later patents, describes a Downloadable as
11 an “applet,” a small interpretable or executable application program, and provides that “a
12 Downloadable is used in a distributed environment such as the Java™ distributed
13 environment produced by Sun Microsystems or in the Active X™ distributed environment
14 produced by Microsoft Corporation.” *See* ‘520 Patent, at Col. 1:31-32, 34-38. Because
15 such examples existed in the 1990s, there should be an objective standard for the size of a
16 “small” program. While “absolute or mathematical precision” was not required, some
17 objective boundary should be identifiable from the disclosed embodiments. *See Biosig*
18 *Instruments*, 738 F.3d at 1381.

19 Finjan opposed ESET’s initial motion for summary judgment for indefiniteness as
20 to the scope of “small” on the grounds that a numerical limitation or cut-off is not necessary
21 because a skilled artisan could determine if an application is “small” from the examples in
22 the ‘962 patent and based on the context. Finjan, however, did not provide an explanation
23 as to how that skilled artisan would therefore interpret “small” or the context that would
24 apply. [Doc. No. 610, at 8 and 15.]²

25
26
27 ² Finjan has also argued that the Court should reconsider its incorporation of “small” into the construction
28 of Downloadable and disregard that modifier as other district courts have done to avoid this definiteness
issue. [Doc. No. 812, at 6.] This solution may resolve Finjan’s problem with defining “small,” but the fact
that the Court’s construction results in indefiniteness is not a basis for reconsideration.

1 ESET argued then, as it does now, that Finjan’s experts did not provide any objective
2 boundaries for a “small” application program based on what a skilled artisan would have
3 understood was upper end of “small” in the context of application programs being
4 downloaded from a source computer to run on a destination computer at the time the
5 application was filed. [Doc. No. 816, at 5.] Finjan’s contention that the understanding of
6 what is “small” depends on the context is not supported by the intrinsic evidence or even
7 extrinsic evidence of the state of the art at the relevant time. It amounted to “unpredictable
8 vagaries of any one person’s opinion” and therefore failed to provide sufficient notice as
9 to the scope of the term. *Interval Licensing*, 766 F.3d at 1371 (“[A] term of degree fails to
10 provide sufficient notice of its scope if it depends on the unpredictable vagaries of any one
11 persons’ opinion.”)

12 ESET contends that the trial testimony of Finjan expert Dr. Eric Cole did not remedy
13 this defect.³ Dr. Cole presented an explanation how a skilled artisan would interpret
14 “small” that was neither disclosed in his previous declaration to the Court (small meant “a
15 few megs ... something that is not multiple gigs or really large” [Doc. No. 806-1, at 17])
16 or anchored to the specification or prosecution history. Rather than providing a range of
17 application size that would have been construed as “small” by an artisan in 1997, Dr. Cole
18 testified on Finjan’s behalf that an application would be understood to be small if it “did
19 not require installation” and opined that “small” depends not on size but on the function.
20 Dr. Cole testified that a small executable is an application that does not require installation
21 is “self-contained” and is “just running automatically” which is “typical if you go to any
22 website nowadays,” whereas an executable that is not small “requires installation” and has
23 “a lot of shared libraries and dlls and other programs” in order to run. [Doc. No. 812, at
24 12.] Dr. Cole testified that regardless of time period, Internet speed and other factors related
25

26
27 ³ Although the trial was terminated early due to the pandemic, Dr. Cole’s testimony was completed. Finjan
28 suggests that Dr. Cole’s testimony at a future trial will replace his completed testimony, but a subsequent
trial is not an opportunity for Dr. Cole to change his opinions or supplement them with support he did not
provide on the record at the first trial. [Doc. No. 816, at 11.]

1 to capacity, what fits the criteria of “small” may change but this distinction (installed or
2 not installed) is constant. Dr. Cole did not however provide support from the specification,
3 the prosecution history, or from any extrinsic sources in the relevant time period, for this
4 new explanation that a skilled artisan in 1997 would understand “small” to be “uninstalled”
5 or “not requiring installation.”

6 In sum, Finjan never offered evidence of a reasonable range for the size of a small
7 executable or interpretable application program as understood by a skilled artisan in 1997
8 based on examples provided in the patent specification. Instead, Finjan elected at trial to
9 offer a new understanding without reference to the size of the application as the objective
10 boundary of a “small” application. Finjan’s new definition is not supported by the
11 specification or prosecution history. It may be convenient to support Finjan’s
12 infringement contentions against ESET’s accused devices, but Finjan’s new explanation
13 does provide clear notice of what constitutes a “small executable or interpretable
14 application program.”

15 **IV. Conclusion**

16 For the foregoing reasons, the Court finds that the term “Downloadable” as used
17 in the patents at-issue is indefinite. Accordingly, it is hereby **ORDERED** that ESET’s
18 motion for summary judgment of invalidity of Finjan’s United States Patent Nos.
19 6,154,844; 6,804,780; 8,079,086; 9,189,621; and 9,219,755 for indefiniteness is
20 **GRANTED**.

21 It is **SO ORDERED**.

22 Dated: March 23, 2021



23
24 Hon. Cathy Ann Bencivengo
25 United States District Judge
26
27
28

EXHIBIT B

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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
(SAN JOSE DIVISION)

FINJAN LLC, a Delaware Limited Liability
Company,

Plaintiff,

v.

CISCO SYSTEMS, INC., a California
Corporation,

Defendant.

Case No. 5:17-cv-00072-BLF-SVK

**FINJAN LLC'S OPPOSITION TO CISCO
SYSTEMS, INC.'S MOTION FOR
JUDGMENT OF INVALIDITY OF THE
'844, '780 AND '494 PATENTS BASED ON
COLLATERAL ESTOPPEL**

I. INTRODUCTION

Finjan’s Motion for Reconsideration of the ESET Court’s summary judgment order (the “ESET Order”) is currently pending, having been filed on April 12, 2021. If granted, the decision will undo the invalidity determination for the ’844 and ’780 Patents, and those patents could then be included in the upcoming trial in this case. However, until that motion is ruled upon, the ESET Order is not “sufficiently firm” to be accorded conclusive effect. And from a practical standpoint, applying collateral estoppel now to find those patents invalid in this case runs the risk of having to reverse course, should the Court in ESET grant the Motion for Reconsideration.

The ’494 Patent was not asserted in ESET, so it is not addressed in the ESET Order. Moreover, this Court has construed the term “downloadable” in the ’494 Patent in a manner that does not include the term “small,” which was the basis for the ESET Court’s indefiniteness determination as to the ’844 and ’780 Patents. And while Cisco argues collateral estoppel should apply to the ’494 Patent, the decision to do so is completely within this Court’s discretion.

II. BACKGROUND

Multiple courts—including in Finjan’s cases against McAfee, Blue Coat, Proofpoint, Symantec, SonicWall, and Rapid7—have construed the term “downloadable” identical to the Court’s construction in this case. Indeed, in this Court’s first *Blue Coat* trial, the jury found that Blue Coat infringed claims of the ’844 and ’780 Patents by applying the Court’s construction of “downloadable.” (See Exh.¹ A at 2-3.) The Federal Circuit affirmed those findings on appeal. *Finjan, Inc. v. Blue Coat Sys., Inc.*, 879 F.3d 1299, 1306-07 (Fed. Cir. 2018). With this track record of courts consistently construing “downloadable” to have the same meaning, it is not surprising Cisco stipulated to that same construction in this case (ECF 85 at 1), and that this Court adopted the stipulated construction on July 23, 2018. (ECF 134 at 5.)

In contrast, the construction of “downloadable” by the Court in ESET stands alone. It is the only court that inserted the word “small” in the construction, as set out in the ESET Court’s claim

¹ All exhibits cited herein are attached to the declaration of K. Nicole Williams ISO Finjan’s Opp’n to Mot. For Judgment of Invalidity, filed contemporaneously herewith.

1 construction order on November 14, 2017. (*See* Exh. B at 3.) Yet even after the Court in ESET
 2 entered its outlier construction, Cisco continued to urge this Court to adopt a construction that did
 3 not include the word “small.” In the Joint Claim Construction and Pre-Hearing Statement, the
 4 parties jointly requested that this Court construe “downloadable” without the word “small.” (ECF
 5 85 at 1.) Cisco maintained that position in its claim construction briefing, in which, despite using
 6 the term “downloadable” 285 times, Cisco never once used the word “small.” (ECF 112.) This
 7 Court held a *Markman* hearing, and again Cisco did not withdraw its agreed-upon construction.
 8 (ECF 132.) In July 2018, this Court construed the term “downloadable” as jointly requested by the
 9 parties and in the same way the term had been construed in every case except ESET. (ECF 134 at
 10 5.)

11 In Finjan’s action against ESET, a jury trial commenced on March 10, 2020, which was
 12 halted shortly thereafter due to the COVID-19 pandemic. (*See* Exh. C.) On a renewed motion for
 13 summary judgment following the mistrial, the ESET Court found that “Finjan never offered
 14 evidence of a reasonable range for the size of a small executable” and held five Finjan patents invalid
 15 as indefinite, including the ’780 and ’844 Patents asserted here. (*See* Exh. D at 8.) On April 12,
 16 2021, Finjan moved for reconsideration of the ESET Order because there was clear error in shifting
 17 the burden to Finjan to prove patent validity and the order was manifestly unjust since, at the time
 18 of the mistrial, neither party had presented evidence on whether downloadable was indefinite. (*See*
 19 *generally* Exh. E.)

20 **III. LEGAL STANDARDS**

21 Collateral estoppel is considered under the law of the regional circuit. *RF Del., Inc. v. Pac.*
 22 *Keystone Techs., Inc.*, 326 F.3d 1255, 1261 (Fed. Cir. 2003). In the Ninth Circuit, collateral estoppel
 23 applies in a patent case if: “(1) the issue necessarily decided at the previous proceeding is identical
 24 to the one which is sought to be re-litigated; (2) the first proceeding ended with a final judgment on
 25 the merits; and (3) the party against whom collateral estoppel is asserted was a party or in privity
 26 with a party at the first proceeding.” *Droplets, Inc. v. Yahoo! Inc.*, 2019 WL 5781915, at *2 (N.D.
 27 Cal. Oct. 15, 2019) (citing *Hydranautics v. FilmTec Corp.*, 204 F.3d 880, 885 (9th Cir. 2000)). The
 28 party asserting issue preclusion bears the burden of showing these elements are met. *Hydranautics*,

204 F.3d at 885. A “final judgment” for purposes of issue preclusion can be any prior adjudication of an issue in another action that is determined to be “sufficiently firm” to be accorded conclusive effect. *Elan Microelectronics Corp. v. Apple, Inc.*, 2010 WL 4510909, at *3 n.3 (N.D. Cal. Nov. 1, 2010). The Ninth Circuit has set forth several factors that should be considered when determining whether an order is “sufficiently firm” including “whether the parties were fully heard.” *See Abbott Diabetes Care Inc. v. Roche Diagnostics Corp.*, 2007 WL 1239220, at *12-*13 (N.D. Cal. Apr. 27, 2007) (citing *Luben Indus., Inc. v. United States*, 707 F.2d 1037, 1040 (9th Cir. 1983)).

Even when all three elements are met, whether to apply the collateral estoppel bar is solely within the court’s discretion. *United States v. Geophysical Corp. of Alaska*, 732 F.2d 693, 697 (9th Cir. 1984). This broad discretion to trial courts allows them “to take potential shortcomings or indices of unfairness into account when considering whether to apply . . . issue preclusion, even where the above-listed standard prerequisites are met.” *Syverson v. Int’l Bus. Machines Corp.*, 472 F.3d 1072, 1078-79 (9th Cir. 2007); *see also Neev v. Alcon*, 2016 WL 9051170 at *12-13 (C.D. Cal. Dec. 22, 2016), *aff’d sub nom. Neev v. Alcon Lensx Inc.*, 774 F. App’x 680 (Fed. Cir. 2019) (declining to apply collateral estoppel to claim construction where it would neither promote uniformity nor judicial efficiency).

IV. ARGUMENT

A. Collateral Estoppel Is Not Yet Applicable As To The ‘844 and ‘780 Patents

Cisco has failed to meet its burden to show that collateral estoppel applies because the ESET Order as to the ‘844 and ‘780 is not “sufficiently firm,” under *Hydranautics*. A Motion for Reconsideration is pending and the ESET Court has not ruled upon that motion nor entered final judgment.

The ESET Court’s original finding of indefiniteness as to the ‘844 and ‘780 was based on an incomplete presentation of the evidence—the testimony of *one expert* who addressed *infringement* on only *one of the five* patents before a mistrial was declared. (See Exh. E at 5-12.) ESET, the party with the burden of proof on invalidity, had not even begun its case. The judge and jury had yet to hear that ESET’s expert on invalidity had *never* opined that, in his opinion, the term “small” rendered the claims indefinite. Nor had they heard that ESET’s invalidity expert had no

problem understanding and applying the term when analyzing the prior art. (*See* Exh. E at 5-7; Exh. F at 5-8.) The ESET Court also did not account for the testimony of Finjan’s expert on validity, who—but for the mistrial—would have explained in rebuttal how a person of ordinary skill in the art would understand the objective bounds of the claim term “downloadable.” (*See* Exh. F at 1-5.) Given that the original ESET Order was entered before the parties were “sufficiently heard” and Finjan’s Motion for Reconsideration is still pending, finding the ’844 and ’780 patents invalid in this case now would be premature. The Finjan action against ESET has not ended with final judgment on the merits, and is insufficiently firm to create a preclusive effect. *See, e.g., Rambus Inc. v. Hynix Semiconductor Inc.*, 569 F. Supp. 2d 946, 968 (N.D. Cal. 2008) (finding issue preclusion did not apply to prior claim constructions where judgment in prior case was not final).

B. The Court Should Decline to Apply Collateral Estoppel To The ’494 Patent

The Court has discretion to decline to apply collateral estoppel, even if it finds the Ninth Circuit factors are satisfied. Here, considerations of fairness and uniformity counsel against applying the collateral estoppel bar to the ’494 Patent. *See, e.g., Neev*, 2016 WL 9051170 at *12-13; *see also Syverson*, 472 F.3d at 1078-79.

First, the ’494 Patent was not before the ESET Court; therefore there has been no finding of invalidity as to that patent. Second, this Court has construed the term “downloadable” in the claims of the ’494 Patent the same way seven of the eight courts have construed that term, i.e., one that does not include the term “small.” The construction of “downloadable” in the ESET case stands in contrast to each of the other cases, and the ESET Court’s indefiniteness finding is predicated on that outlier construction. This Court is not bound by the ESET Court’s construction and, in fact, has said that it does not intend to change the construction which the parties agreed to and have been operating under throughout this case.

In light of all of the above, applying collateral estoppel to the ’494 Patent would be counter to the very rationale for the doctrine itself. Collateral estoppel is meant to prevent inefficient re-litigation of identical issues and promote uniformity in the treatment of a given patent and prior decisions. *See Neev*, 2016 WL 9051170 at *12-13. Applying estoppel here would treat the ’494

1 Patent *inconsistently* with six other cases – in which the courts’ construction has not created any
2 problems for juries, judges, or the parties.

3 In addition, from a fairness perspective, Cisco has consistently advocated for the
4 construction of “downloadable” that this Court adopted, even after the ESET Court entered its
5 outlier construction. Cisco is now seizing on the ESET Order, which is contrary to Cisco’s own
6 proposed construction, to try to avoid trial on the ’494, which was not before the court in ESET and
7 therefore, not the subject of the ESET Order. Finjan submits the fair path is for this Court to exercise
8 its discretion and decline to apply the collateral estoppel bar to the ’494 Patent. *See Syverson*, 472
9 F.3d at 1079.

10 None of Cisco’s cited cases require a different result. For example, *Ohio Willow Wood*
11 does not support Cisco’s sweeping conclusion that a court *must* apply the collateral estoppel bar if
12 the collateral estoppel factors are met. In that case, the defendant timely moved for summary
13 judgment based on collateral estoppel, the district court *chose* to grant the motion, and the Federal
14 Circuit affirmed. *Ohio Willow Wood Co. v. Alps S., LLC*, 735 F.3d 1333, 1341-43 (Fed. Cir.
15 2013). Likewise, in the *Nestle USA* and *Papst Licensing* cases, the Federal Circuit affirmed PTAB
16 claim construction decisions where collateral estoppel was applied. *See Nestle USA, Inc. v.*
17 *Stueben Foods, Inc.*, 884 F.3d 1350, 1352 (Fed. Cir. 2018); *Papst Licensing GMBH & Co. v.*
18 *Samsung Elecs. Am., Inc.*, 924 F.3d 1243, 1252-53 (Fed. Cir. 2019). Finally, in *Arunachalam v.*
19 *Presidio Bank*, 801 F. App’x 750 (Fed. Cir. 2020), the Federal Circuit merely affirmed the lower
20 court’s exercise of its discretion in *choosing* to apply the collateral estoppel bar. *Id.* at 753-54.
21 None of these cases suggest that this Court *must* apply collateral estoppel, or that the Federal
22 Circuit would fault this Court if, in considering fairness and uniformity, this Court *chooses* to
23 exercise its discretion and decline to apply the collateral estoppel bar to the ’494 Patent.

24 V. CONCLUSION

25 For the foregoing reasons Finjan respectfully requests the Court deny Cisco’s Motion as to
26 the ’844 and ’780 Patents unless and until final judgment is entered by the ESET Court and deny
27 Cisco’s motion as to the ’494 Patent and allow that patent to proceed to trial.

Dated: April 26, 2021

FISH & RICHARDSON P.C.

By: /s/ Juanita R. Brooks
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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
(SAN JOSE DIVISION)

FINJAN LLC, a Delaware Limited Liability
Company,

Plaintiff,

v.

CISCO SYSTEMS, INC., a California
Corporation,

Defendant.

Case No. 5:17-cv-00072-BLF-SVK

**DECLARATION OF K. NICOLE
WILLIAMS IN SUPPORT OF FINJAN
LLC'S OPPOSITION TO CISCO
SYSTEMS, INC.'S MOTION FOR
JUDGMENT OF INVALIDITY OF THE
'844, '780 AND '494 PATENTS BASED ON
COLLATERAL ESTOPPEL**

DECLARATION OF K. NICOLE WILLIAMS IN
SUPPORT OF FINJAN'S OPPOSITION TO
CISCO'S MOTION FOR JUDGMENT OF
INVALIDITY
Case No. 5:17-cv-00072-BLF-SVK

I, K. Nicole Williams, hereby declare and state as follows:

1. I am a principal in the law firm of Fish & Richardson P.C., counsel of record for Plaintiff Finjan LLC in the above-captioned matter. I have personal knowledge of all the facts contained herein and, if called as a witness, I could and would testify competently thereto.

2. Attached as Exhibit A is a true and correct copy of *Finjan Inc. v. Blue Coat Sys., Inc.*, No 5-13-cv-03999, ECF 438 (N.D. Cal. Aug. 4, 2015).

3. Attached as Exhibit B is a true and correct copy of *Finjan, Inc. v. ESET, LLC*, No. 3:17-cv-0183-CAB, ECF 195 (S.D. Cal. Nov. 14, 2017).

4. Attached as Exhibit C is a true and correct copy of *Finjan, Inc. v. ESET, LLC*, No. 3:17-cv-0183-CAB, ECF 783 (S.D. Cal. Mar. 16, 2020).

5. Attached as exhibit D is a true and correct copy of *Finjan, Inc. v. ESET, LLC*, No. 3:17-cv-0183-CAB, ECF 869 (S.D. Cal. Mar. 29, 2021).

6. Attached as Exhibit E is a true and correct copy of *Finjan, Inc. v. ESET, LLC*, No. 3:17-cv-0183-CAB, ECF 872-1 (S.D. Cal. April 12, 2021).

7. Attached as Exhibit F is a true and correct copy of *Finjan, Inc. v. ESET, LLC*, No. 3:17-cv-0183-CAB, ECF 872-2 (S.D. Cal. April 12, 2021).

I declare under the penalty of perjury of the laws of the United States of America that the foregoing is true and correct. Executed on April 26, 2021, in Cardiff, California.

By: /s/ K. Nicole Williams
K. Nicole Williams

EXHIBIT A

1 **IN THE UNITED STATES DISTRICT COURT**
2 **FOR THE NORTHERN DISTRICT OF CALIFORNIA**
3 **SAN JOSE DIVISION**

4
5 FINJAN, INC., a Delaware Corporation,

Case No.: 13-CV-03999-BLF

6 Plaintiff,

VERDICT FORM

7
8 v.

9 BLUE COAT SYSTEMS, INC., a Delaware
Corporation,

10 Defendant.
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VERDICT FORM

When answering the following questions and filling out this Verdict Form, please follow the directions provided throughout this Verdict Form. Your answer to each question must be unanimous. Some of the questions contain legal terms that are defined and explained in detail in the Jury Instructions. Please refer to the Jury Instructions if you are unsure about the meaning or usage of any legal term that appears in the questions below.

We, the jury, unanimously agree to the answers to the following questions and return them under the instructions of this court as our verdict in this case.

QUESTION 1: Did Finjan prove by a preponderance of the evidence that Blue Coat's product or combination of products as identified below literally infringes any of the following claims of the Asserted Patents? Answer "Yes" or "No" for each claim.

'844 Patent WebPulse	Claim 1 <u>Yes</u>	Claim 15 <u>Yes</u>
	Claim 7 <u>Yes</u>	Claim 41 <u>Yes</u>
	Claim 11 <u>Yes</u>	
'822 Patent ProxySG	Claim 9 <u>NO</u>	Claim 10 <u>NO</u>
'633 Patent ProxySG + CAS + MAA	Claim 14 <u>NO</u>	
'731 Patent ProxySG + WebPulse	Claim 1 <u>Yes</u>	Claim 17 <u>Yes</u>
'968 Patent ProxySG + WebPulse	Claim 1 <u>Yes</u>	
'780 Patent ProxySG + ProxyAV	Claim 9 <u>Yes</u>	Claim 13 <u>Yes</u>

For each claim you did not find to be literally infringed, answer Question 2.

QUESTION 2: Did Finjan prove by a preponderance of the evidence that Blue Coat's product or combination of products as identified below infringe under the doctrine of equivalents? **Answer** "Yes" or "No" for each claim.

<u>'844 Patent</u> WebPulse	Claim 1 <u>Yes</u> Claim 7 <u>Yes</u> Claim 11 <u>Yes</u>
<u>'822 Patent</u> ProxySG	Claim 9 <u>No</u> Claim 10 <u>No</u>
<u>'633 Patent</u> ProxySG + CAS + MAA	Claim 14 <u>Yes</u>
<u>'968 Patent</u> ProxySG + WebPulse	Claim 1 <u>Yes</u>
<u>'780 Patent</u> ProxySG + ProxyAV	Claim 9 <u>Yes</u> Claim 13 <u>Yes</u>

1 **QUESTION 3:** What are the dates of invention for the '844 Patent and the '731 Patent?

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3 '844 Patent: November 8, 1996

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5 '731 Patent November 6, 1997

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7 Regardless of the dates you find, please answer Question 4 with respect to each patent.
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QUESTION 4: Did Blue Coat prove by clear and convincing evidence that any of the following claims of the Asserted Patents are invalid because they are anticipated? Answer "Yes" or "No" for each claim.

<p><u>'844 Patent</u> U.S. Patent No. 6,253,370 ("Abadi")</p>	<p>Claim 1 <u>No</u> Claim 15 <u>No</u> Claim 7 <u>No</u> Claim 41 <u>No</u> Claim 11 <u>No</u></p>
<p><u>'822 Patent</u> U.S. Patent No. 5,983,348 ("Ji")</p>	<p>Claim 9 <u>No</u> Claim 10 <u>No</u></p>
<p><u>'633 Patent</u> U.S. Patent No. 5,983,348 ("Ji")</p>	<p>Claim 14 <u>No</u></p>
<p><u>'731 Patent</u> IBM WebSphere Edge Server: New Features and Function in Version 2, IBM Redbooks ("Braswell")</p>	<p>Claim 1 <u>No</u> Claim 17 <u>No</u></p>
<p><u>'968 Patent</u> U.S. Patent No. 6,722,214 ("McClain")</p>	<p>Claim 1 <u>No</u></p>
<p><u>'780 Patent</u> U.S. Patent No. 5,815,709 ("Waldo")</p>	<p>Claim 9 <u>No</u> Claim 13 <u>No</u></p>

1 **Answer Question 5(a)-(f) only if you have found one or more claims of the Asserted Patents to be**
2 **infringed and not invalid from Questions 1, 2 and 4.**

3
4 **QUESTION 5(a):** If you found any of the asserted claims of the '844 Patent to be infringed and not
5 invalid, what amount of damages has Finjan proven it is entitled to that would fairly and reasonably
6 compensate it for Blue Coat's infringement for the life of the patent?

7 \$ 24,000,000
8

9 **QUESTION 5(b):** If you found any of the asserted claims of the '822 Patent to be infringed and not
10 invalid, what amount of damages has Finjan proven it is entitled to that would fairly and reasonably
11 compensate it for Blue Coat's infringement for the life of the patent?

12 \$ 0
13

14
15 **QUESTION 5(c):** If you found the asserted claim of the '633 Patent to be infringed and not invalid,
16 what amount of damages has Finjan proven it is entitled to that would fairly and reasonably
17 compensate it for Blue Coat's infringement for the life of the patent?

18 \$ 1,666,700
19

20 **QUESTION 5(d):** If you found any of the asserted claims of the '731 Patent to be infringed and not
21 invalid, what amount of damages has Finjan proven it is entitled to that would fairly and reasonably
22 compensate it for Blue Coat's infringement for the life of the patent?

23 \$ 6,000,000
24

25
26 [continued to the next page]
27
28

1 **QUESTION 5(e):** If you found the asserted claim of the '968 Patent to be infringed and not invalid,
2 what amount of damages has Finjan proven it is entitled to that would fairly and reasonably
3 compensate it for Blue Coat's infringement for the life of the patent?

4 \$ 7,750,000
5

6 **QUESTION 5(f):** If you found any of the asserted claims of the '780 Patent to be infringed and not
7 invalid, what amount of damages has Finjan proven it is entitled to that would fairly and reasonably
8 compensate it for Blue Coat's infringement for the life of the patent?
9

10 \$ 111,787
11
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1 You have now reached the end of the verdict form and should review it to ensure it accurately
2 reflects your unanimous determinations. The Presiding Juror should then sign and date the verdict
3 form in the spaces below and notify the Security Guard that you have reached a verdict. The Presiding
4 Juror should retain possession of the verdict form and bring it when the jury is brought back into the
5 courtroom.

6
7
8 DATED: August 4th, 2015


By: 
Presiding Juror

EXHIBIT B

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA

FINJAN, INC.,

Plaintiff,

v.

ESET, LLC, a California Limited Liability
and ESET SPOL. S.R.O., a Slovak
Republic Corporation,

Defendants.

Case No.: 3:17-cv-0183-CAB-(BGS)

CLAIM CONSTRUCTION ORDER

On September 25 and 26, 2017, the Court held a hearing to construe certain terms and phrases of the following patents: U.S. Patent Nos. 6,154,844; 6,804,780; 8,079,086; 9,189,621; 9,219,755; and 7,975,305. The parties submitted briefing in accordance with this District's local patent rules and the case management order. A tutorial was presented by both sides to assist the Court with the history and background of the patents.

The Court requested further briefing regarding certain terms. Having now considered all the submissions of the parties, the arguments of counsel and for the reasons set forth at the hearing and herein, the Court hereby enters the claim constructions set forth below.

1 **A. “Downloadable” in U.S. Patent Nos. 6,154,844; 6,804,780; 8,079,086;**
 2 **9,189,621 and 9,219,755**

3 The parties seek construction of the term **Downloadable** as it is used in five of the
 4 patents at issue. This claim term can be traced through two branches of the family tree of
 5 this patent (*see* Attachment A) with somewhat differing definitions. The Court however
 6 concludes that the variations between the definitions can be reconciled and the
 7 specifications in their entirety give notice of what is encompassed by the claim term
 8 **Downloadable** to one of skill in the art.

9 **Downloadable** initially appears as a defined term in the specification of the
 10 6,167,520 patent, and its continuation the 6,480,962 patent, as *a small executable or*
 11 *interpretable application program which is downloaded from a source computer and run*
 12 *on a destination computer.*

13 The specification of the 6,092,194 patent, and its continuation the ‘780 patent (which
 14 is at issue in this litigation), define **Downloadable** *as an executable application program*
 15 *which is downloadable from a source computer and run on the destination computer.* The
 16 specification however provides as examples of a **Downloadable**, application programs
 17 such as Java™ applets, known as little application programs in machine language, and
 18 JavaScripts™ scripts, an interpretable application program. These examples are in accord
 19 with the definition, incorporated by reference, set forth in the ‘520 patent. The ‘194 patent
 20 and its progeny therefore conform to the ‘520 patent’s definition of **Downloadable** as *small*
 21 *executable or interpretable application programs* through the use of the examples in the
 22 specifications. The Court finds that one of skill in the art would be able to ascertain what
 23 is claimed as a **Downloadable** in the context of these patents, and that in light of the
 24 examples provided in the ‘194 patent specification, concludes that the meaning of
 25 **Downloadable** is consistent with the definition provided in the ‘520 patent.

26 The ‘844 patent (which is at issue in this litigation) defines **Downloadable** *as an*
 27 *executable application program which is downloadable from a source computer and run*
 28 *on the destination computer* and also includes references to small executable and

1 interpretable application programs as examples of a **Downloadable**. The ‘844 patent
2 incorporates by reference the ‘520 patent and ‘194 patent. The Court finds that the
3 definition of **Downloadable** based on the ‘844 patent specification, the examples provided
4 therein and the incorporation of the ‘520 patent and the ‘194 patent, informs one of skill in
5 the art with reasonable certainty the scope of the invention. The entirety of the
6 specification’s description would inform that **Downloadable** includes executable and
7 interpretable application programs, in accordance with the examples and incorporated
8 references.

9 The ‘822 patent is a Continuation in Part of both the ‘962 patent and ‘780 patent and
10 incorporates those patents by reference. Its continuation patents, including the ‘086 patent,
11 ‘621 patent and ‘755 patent, which are at issue in this litigation, do not include a definition
12 of **Downloadable** in the specification but incorporate by reference the ‘962 patent and the
13 ‘780 patent, and their definitions and examples of a **Downloadable**.

14 The Court finds that the two branches of the family tree of the patents at issue inform
15 that a **Downloadable** in the context of these patents means a *small executable or*
16 *interpretable application program which is downloaded from a source computer and run*
17 *on a destination computer*. This construction comports with the plain definition set forth
18 in the ‘520 patent and the ‘962 patent, and is supported by the written description including
19 the definition and the examples set forth in the ‘194 patent and its progeny, and in the
20 entirety of specification of the ‘844 patent.

21 The Court therefore construes the term **Downloadable** in all five patents as *a small*
22 *executable or interpretable application program which is downloaded from a source*
23 *computer and run on a destination computer*.

B. U.S. Patent No. 6,154,844

The parties sought construction of the following phrase appearing in various claims of the '844 patent: **before the web server makes the Downloadable available to web clients**. The Court's construction for this term is: *Before the Downloadable is available on a web server to be called up or forwarded to a web client*. ('844 @ Col. 3:32-52; Col. 4:65 - Col. 5:13; Figure 1.)

C. U.S. Patent No. 6,804,780

The parties sought construction of the following terms and phrases appearing in various claims of the '780 patent. The Court's constructions for these terms are:

Claim Term	COURT'S CONSTRUCTION
software components required to be executed by the Downloadable	<i>components of code that the Downloadable is required to execute</i> (agreed construction)
ID generator	Defendant's request for application of 112 ¶6 denied. "ID generator" is not a nonce term as advocated by Defendant. It is a common name for a known program construct that would be familiar to one of skill in the art to perform a function further identified by its modifier.
performing a hashing function on the Downloadable and the fetched software components to generate a Downloadable ID	<i>performing a hashing function on the Downloadable together with its fetched software components</i> (Adopting PTO Construction from the IPR of the '780 patent April, 2016.)

D. U.S. Patent No. 7,975,305

The parties sought construction of the following phrase appearing in various claims of the '305 patent, **network interface, housed within a computer**. Defendant's proposed construction that "housed within a computer" necessarily limits the structure of the network interface to a hardware component is declined. The specification includes software interface examples. The Court therefore finds in the context of the patent, the use of "housed" in contrast to "stored" does not dictate that the claim be limited to hardware components. To the extent clarification is required the Court construes this phrase as *network interface, contained within the computer*.

The parties agreed construction for **database, a collection of interrelated data organized according to a database schema to serve one or more applications**, is adopted.

E. U.S. Patent No. 8,079,086

The parties sought construction of the following terms appearing in various claims of the '086 patent. The Court's constructions for these terms are:

Claim Term	COURT'S CONSTRUCTION
appended Downloadable	<p><i>a Downloadable with a representation of the DSP data attached to the end of the Downloadable</i></p> <p>Declaration of Dr. Spafford, ¶¶36-39, and references cited therein, that one skilled in the art at the time would understand "append" to mean attach or add to the end of the existing file. The claim recites appending a representations of the DSP data to the Downloadable indicating an order.</p>
destination computer	<p><i>Separate computer receiving the appended Downloadable</i></p>

file appender	Defendant's request for application of 112 ¶ 6 is denied. "File appender" is not a nonce term as advocated by Defendant. It is a common name for a known program construct that would be familiar to one of skill in the art to perform a function further identified by its modifier.
Transmitter	Defendant's request for application of 112 ¶ 6 is denied. "Transmitter" is not a nonce term as advocated by Defendant. It a common name for a known program construct that would be familiar to one of skill in the art.

F. U.S. Patent No. 9,189,621

The parties sought construction of the following terms appearing in various claims of the '621 patent. The Court's constructions for these terms are:

Claim Term	COURT'S CONSTRUCTION
wherein the information pertaining to the downloadable includes information pertaining to operation of the downloadable and distinct from information pertaining to the request	Defendant asserts that this phrase is indefinite as it is not possible to ascertain the meaning of "information pertaining to the operation of the downloadable that is distinct from information pertaining to the request." The Court finds that in the context of the claim in its entirety and for the reasons set forth on the record, one of skill in the art would understand the meaning and scope of this claim language, and no further construction is needed.
a response engine for performing a predetermined	Defendant asserts that use of "response engine" is the equivalent of "means for" claiming and is

<p>responsive action based on the comparison</p>	<p>limited to the structures disclosed in the ‘520 Patent at Figs. 5 and 6, Steps 525, 530, 540 and 610-30. Plaintiff asserts that “engine” is a common name for a known program construct that would be familiar to one of skill in the art to perform a function further identified by its modifier, in this case “response.” The Court agrees that “engine” is not a nonce term as advocated by Defendant, and that the claim provides sufficient structure for one skilled in the art.</p> <p>Defendant’s request for application of 112 ¶ 6 is denied.</p>
<p>a response engine for performing a predetermined responsive action based on the comparison with the information pertaining to the predetermined suspicious downloadable</p>	<p>Defendant asserts that “response engine” is the equivalent of “means for” claiming and no structure to perform this function is disclosed. Plaintiff asserts that “engine” is a common name for a known program construct that would be familiar to one of skill in the art to perform a function further identified by its modifier, in this case “response.” “Engine” is not a nonce term.</p> <p>Defendant’s request for application of 112 ¶ 6 is denied.</p>
<p>Database</p>	<p><i>a collection of interrelated data organized according to a database schema to serve one or more applications</i></p> <p>(joint construction)</p>

1 The final construction at issue with regard to the ‘621 patent is a “means for”
2 limitation. An element of a claim may be expressed as a means for performing a specified
3 function without the recital of the structure and is construed to cover the corresponding
4 structure described in the specification or equivalents thereof. 35 U.S.C. § 112, ¶ 6. The
5 limitation at issue appears in claim 15, which is dependent on claim 10.

6 Claim 10. A system for reviewing an operating system call issued by a
7 downloadable, comprising:

8 ...
9 a plurality of operating system probes for monitoring substantially in parallel
10 a plurality of subsystems of an operating system during runtime for an event
11 caused from a request made by a Downloadable, wherein the plurality of
12 subsystems includes a network system;

13
14 Claim 15. The system of claim 10, wherein the plurality of operating system
15 probes operating substantially in parallel for monitoring the operating system
16 includes **means for monitoring a request sent to a downloadable engine.**

17 The parties agree that the “means for” element of claim 15 is governed by 35 U.S.C.
18 § 112, ¶ 6. The patent specification must disclose with sufficient particularity the
19 corresponding structure for performing the claimed function and clearly link that structure
20 to the function. *Triton Tech of Tx., LLC. V. Nintendo of Am., Inc.*, 753 F.3d 1375, 1378
21 (Fed. Cir. 2014). The claimed function is “monitoring a request sent to a downloadable
22 engine.” After the claim construction hearing, the Court requested supplemental briefing
23 from the parties identifying with sufficient particularity the corresponding structure in the
24 specification for performing the claimed function. [Doc. 178-1.]

25 The plaintiff refers to the specification of the ‘962 patent [Doc. No. 138-9],
26 incorporated by reference in the ‘621 patent, for the corresponding structure that supports
27 this “means for” claim. Plaintiff directs the Court to the component identified in the
28 specification as the request broker 306 described at Col. 4:12-18, Figs. 3 and 4 [*id.* at 6-7,
12] as the corresponding structure providing the function in the system of monitoring a
request sent to a downloadable engine. [See Doc. No. 183 at 3.]

1 The specification describes the system for monitoring requests made by a
 2 Downloadable 140 to a downloadable engine 250 at Col. 3:51 – Col. 5:48. [Doc. No. 138-
 3 9, at 6-7, 12-13.] In the examples provided (*see* Figs. 3 and 4), extensions 304, 404, 405,
 4 406 examine a Downloadable's request for access to classes 302 of a Java™ Virtual
 5 Machine (the downloadable engine 250) or to message calls 401, DDE calls 402 and DLL
 6 calls 403 of a ActiveX™ platform (the downloadable engine 250). The Downloadable's
 7 request to the downloadable engine may be interrupted by the extension which then notifies
 8 the request broker 306 of the Downloadable's request. The request broker 306 in turn
 9 forwards the request to the event router 308. [*Id.*]

10 The extensions 304, 404, 405, 406 monitor requests made to the downloadable engine
 11 250. Col. 5:40-49 (the extensions recognize a request made by a Downloadable to the
 12 downloadable engine, interrupt the processing of the request and generate and forward a
 13 message identifying the incoming Downloadable to request broker which forwards the
 14 message to the event router.); Col. 4:10-15 (each extension 304 manages a respective one
 15 of the Java™ classes, interrupts the request and generates a message to the request broker
 16 306); Col. 5:23-38 (each extension 404, 405, 406 recognizes a call to an ActiveX™
 17 platform 401, 402, 403, and generates a message to the request broker 306). The request
 18 broker 306 forwards the request on for further analysis and response. The structures
 19 identified in the specification corresponding to a **means for monitoring a request sent to**
 20 **a downloadable engine**, are the Java Class extensions 304, the Message Extension 404,
 21 the Dynamic-Data-Exchange Extension 405 and Dynamically-Linked-Library Extension
 22 406, and their equivalents.

F. U.S. Patent No. 9,219,755

The parties sought construction of the following terms appearing in various claims of the '755 patent. The Court's constructions for these terms are:

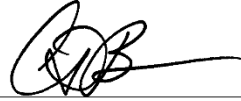
Claim Term	COURT'S CONSTRUCTION
a downloadable engine for intercepting a request message being issued by a downloadable to an operating system	Defendant asserts that "downloadable engine" is the equivalent of "means for" claiming and the disclosed structures disclosed to perform this function are a Java Virtual Machine 250 or Active X Platform 250 ('960 patent, Col. 3:54-56; Fig. 3; Col. 5:25-27; Fig. 4). Plaintiff asserts that "engine" is a common name for a known program construct that would be familiar to one of skill in the art to perform a function further identified by its modifier, in this case "response." The Court agrees that "engine" is not a nonce term as advocated by Defendant, and that the claim provides sufficient structure for one skilled in the art. Defendant's request for application of 112 ¶ 6 is denied.
intercepting an operating system call being issued by the downloadable to an operating system	<i>stopping a request message before the request message is received by the operating system</i>
a response engine for receiving a violation message from the runtime	Defendant asserts that use of "response engine" is the equivalent of "means for" claiming and is limited to the structures disclosed in the '520

environment ... and blocking
... and allowing

Patent, at Figs. 5 and 6, Steps 525, 530, 540 and 610-30. Plaintiff asserts that “engine” is a common name for a known program construct that would be familiar to one of skill in the art to perform a function further identified by its modifier, in this case “response.” The Court agrees that “engine” is not a nonce term as advocated by Defendant, and that the claim provides sufficient structure for one skilled in the art. Defendant’s request for application of 112 ¶6 is denied.

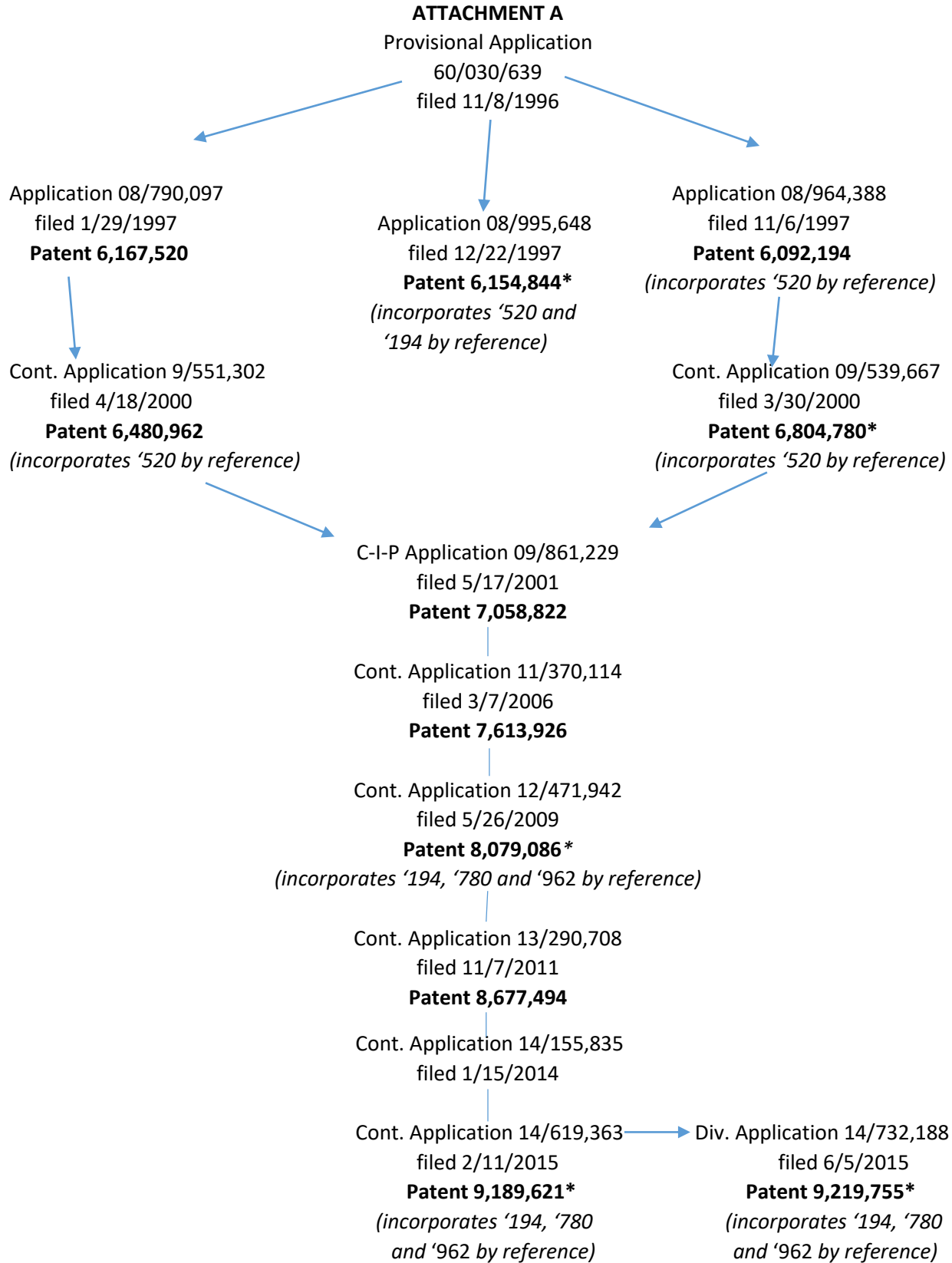
It is **SO ORDERED**.

Dated: November 14, 2017



Hon. Cathy Ann Bencivengo
United States District Judge

Attachment A



*Patents at issue in the litigation.

EXHIBIT C

This is an automatic e-mail message generated by the CM/ECF system. Please DO NOT RESPOND to this e-mail because the mail box is unattended.

*****NOTE TO PUBLIC ACCESS USERS***** Judicial Conference of the United States policy permits attorneys of record and parties in a case (including pro se litigants) to receive one free electronic copy of all documents filed electronically, if receipt is required by law or directed by the filer. PACER access fees apply to all other users. To avoid later charges, download a copy of each document during this first viewing. However, if the referenced document is a transcript, the free copy and 30 page limit do not apply.

U.S. District Court

Southern District of California

Notice of Electronic Filing

The following transaction was entered on 3/16/2020 at 10:35 AM PDT and filed on 3/16/2020

Case Name: Finjan, Inc. v. ESET, LLC et al

Case Number: [3:17-cv-00183-CAB-BGS](#)

Filer:

Document Number: 783(No document attached)

Docket Text:

Minute Entry for proceedings held before Judge Cathy Ann Bencivengo: Status reJury Trial completed on 3/16/2020. 0 Trial Jurors Present. The Court suspended jury trial proceedings and excused the jury for the day. With the agreement of counsel, the Court deems a Mistrial based upon the current state of extraordinary circumstances due to the Coronavirus/COVID-19 Pandemic. The Court will contact counsel upon the conclusion of the national state of emergency for further scheduling of court proceedings. All previously pending dates of trial are hereby vacated. (Court Reporter/ECR Mauralee Ramirez). (Plaintiff Attorney Paul Andre, James Hannah, Kristopher Kastens). (Defendant Attorney Nicola Pisano, Scott Penner, Regis Worley, Jr., Justin Gray). (no document attached) (lmh)

3:17-cv-00183-CAB-BGS Notice has been electronically mailed to:

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3:17-cv-00183-CAB-BGS Notice has been delivered by other means to:

EXHIBIT D

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA

FINJAN, INC.,

Plaintiff,

v.

ESET, LLC, a California Limited Liability
and ESET SPOL. S.R.O., a Slovak
Republic Corporation,

Defendants.

Case No.: 3:17-cv-0183-CAB-BGS

**AMENDED ORDER ON
DEFENDANTS' RENEWED MOTION
FOR SUMMARY JUDGMENT OF
INDEFINITENESS
[Doc. No. 806]**

Before the Court is the renewed motion of Defendants ESET, LLC and ESET spol. s.r.o (collectively "ESET") for summary judgment to invalidate Plaintiff Finjan's United States Patent Nos. 6,154,844; 6,804,780; 8,079,086; 9,189,621; and 9,219,755 ("the patents at-issue") as indefinite pursuant to 35 U.S.C. § 112 based on this Court's construction of the claim term "Downloadable." The motion is fully briefed, and the Court deems it suitable for submission without oral argument.

I. Background

This motion has an unusual history. ESET filed a motion for summary judgment asserting that the patents at-issue are indefinite at the close of fact discovery in this case, and the Court held argument on September 26, 2019. Finding that there were factual disputes regarding what a skilled artisan in 1997 would have understood constituted a

1 “Downloadable” based on the Court’s construction of that term, the Court denied the
2 motion without prejudice. [Doc. No. 699.] It was anticipated that trial testimony would
3 establish what was generally understood in the art in 1997 as a “Downloadable” and such
4 testimony would inform the scope of infringement. [Doc. No. 697, at 22:3-15.]

5 A jury trial commenced in this case on March 10, 2020. After three trial days the
6 Court was forced to vacate the remainder of the trial, excuse the jury and declare a mistrial
7 due to the COVID-19 pandemic and the issuance of the State of California’s stay-home
8 order. [Doc. No. 783.] This District’s continuing moratorium on civil jury trials and
9 backlog of criminal jury trials currently precludes scheduling a new trial in this matter.

10 Having heard testimony from Finjan’s expert during the vacated trial on this issue,
11 however, the Court permitted ESET to renew this motion in consideration of the testimony
12 that was taken. Although Finjan’s patents have been the subject of much litigation, and
13 the term “Downloadable” has been construed by other courts, the issue raised in ESET’s
14 current motion does not appear to have been addressed by any prior constructions.

15 Finjan is the owner of a large family tree of patents for security systems and methods
16 of detecting malware in computer programs. Finjan has litigated many of their patents,
17 including some of the patents at-issue in this motion, in other district courts. Many have
18 also been subject to *inter partes* review by the Patent and Trademark Office (PTO). The
19 Federal Circuit has issued at least nine opinions, precedential and non-precedential, on
20 appeals from district courts and the PTO regarding Finjan patents. Yet none of these orders
21 or opinions discuss how earlier references incorporated into the patents at-issue inform the
22 construction of the term “Downloadable.”

23 II. The Construction of “Downloadable”

24 In 2017, Finjan filed this litigation against defendants ESET asserting infringement
25 of the patents at-issue, and United States Patent No. 7,975,305.¹ Finjan claims priority for
26

27
28 ¹ The ‘305 patent is not subject to this motion as it does not include the claim term “Downloadable.”

1 the patents at-issue back to an application filed on November 8, 1996, Provisional
2 Application 60/030639. [Doc. No. 139-24.] The application is directed at “a system and
3 method for protecting computers from hostile Downloadables,” described as executable
4 application programs automatically downloaded from a source computer and run on the
5 destination computer that might carry computer “viruses.” [Id., at 5-6.] The claim term
6 “Downloadable” is presented as a capitalized term in the provisional application and all the
7 patents at-issue, signaling it is a specifically defined term. The definition of
8 “Downloadables,” however, is not consistent throughout Finjan’s subsequently issued
9 patents. The explicit definitions include:

- 10 • “applets” (little applications) described in the 1990s as small interpreted or
11 executable programs. *See* Provisional Application 60/030639 (filed
12 November 8, 1996) [*Id.* at 5-6.]
- 13 • “Downloadables (i.e., applets)” as “a small executable or interpretable
14 application program which is downloaded from a source computer and run
15 on a destination computer,” in conformity with the original provisional
16 application. *See* U.S. Patent No. 6,167,520, at Col. 1:31-34 (application filed
17 January 29, 1997); U.S. Patent No. 6,480,962, at Col. 1:38-41 (filed April 18,
18 2000).
- 19 • “an executable application program which is downloaded from a source
20 computer and run on a destination computer” (without “i.e., applet,” “small”
21 or “interpretable” included in the definition but using applets and
22 interpretable programs as examples of a “Downloadable” and incorporating
23 the earlier definition by reference). *See* U.S. Patent No. 6,092,194, at Col.
24 1:44-55 (filed November 6, 1997); U.S. Patent No. 6,804,780 at Col. 1:50-60
25 (filed March 30, 2000).

26 Other district courts have determined that “Downloadable” lacked ordinary meaning
27 when the patents were filed and construed it as “an executable application program which
28 is downloaded from a source computer and run on a destination computer,” applying the

1 explicit definition from the ‘194 patent. [Doc. No. 139-10, at 3; Doc. No. 138-4, at 2-5 (the
2 term was not amenable to plain and ordinary meaning and the patent applicant intended to
3 act as the lexicographer of this term, therefore the specification definition controls).] None
4 of these orders, however, discussed the significance of the ‘520 patent’s definition
5 incorporated into the ‘194 patent and its continuations. One district court, without
6 explanation, applied the broader definition from the ‘194 patent specification to the
7 construction of the term “Downloadable” in the ‘962 patent as “the same” definition [id.,
8 at 3, fn. 4], disregarding the fact the ‘962 patent explicitly defines “Downloadable” as “a
9 *small* executable or interpretable application program which is downloaded from a source
10 computer and run on a destination computer.” See U.S. Patent No. 6,480,962, at Col. 1:39-
11 41 (*emphasis added*).

12 Incorporation by reference provides a method for integrating material from various
13 documents into a host document by citing such material in a manner that makes clear that
14 the material is effectively part of the host document as if it were explicitly contained
15 therein. See *Trustees of Columbia Univ. v. Symantec*, 811 F.3d 1359, 1365-66 (Fed. Cir.
16 2016) (*citing Advanced Display Sys. v. Kent State Univ.*, 212 F.3d 1272, 1282 (Fed. Cir.
17 2000) (provisional applications incorporated by reference are effectively part of the
18 specification as though it was explicitly contained therein.)). By incorporating the earlier
19 definition of “Downloadable” from the ‘520 Patent into the ‘194 Patent and subsequent
20 continuations (including the patents at-issue), the scope of the term is limited to “*small*
21 executable or interpretable application programs,” and not *all* executable application
22 programs (*emphasis added*). See *Symantec*, 811 F.3d at 1365 (rejecting a broad
23 interpretation of a claim term in part because a provisional application incorporated by
24 reference the same term more narrowly defined.) Inconsistent language used later cannot
25 support a broad claim construction when the explicit definition is incorporated from earlier
26 patents in the family tree.

27 In this case, the Court concluded that based on its incorporation by reference in all
28 the patents at-issue, the explicit definition of “Downloadables” from the ‘520 patent and

1 the '962 patent, which is supported by the examples provided in the specification, is the
2 proper construction of "Downloadables" – "a small executable or interpretable application
3 program which is downloaded from a source computer and run on a destination computer."
4 [Doc. No. 195.]

5 **III. The Indefiniteness Determination**

6 The Court's claim construction, not unexpectedly, resulted in the present dispute as
7 to the scope of the modifier "small." ESET argues that "small" is a term of degree with
8 not technical meaning or defined boundaries and there is insufficient information in the
9 intrinsic record for a skilled artisan to have clear notice of what constitutes a "small
10 executable or interpretable application program." They further argue that this is
11 demonstrated by the inability of Finjan's experts to come to a consistent opinion as to what
12 objective boundaries constitute a small application program. [806-1, at 5, 17.]

13 The definiteness requirement of paragraph 2 of 35 U.S.C. §112 requires that the
14 "specification shall conclude with one or more claims particularly pointing out and
15 distinctly claiming the subject matter which the applicant regards as his invention." The
16 definiteness requirement focuses on whether "a patent's claims, viewed in light of the
17 specification and prosecution history inform those skilled in the art about the scope of the
18 invention with reasonable certainty." *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S.
19 898, 910 (2014). The inquiry "trains on the understanding of a skilled artisan at the time
20 of the patent application." *Id.* at 911.

21 Terms of degree must provide sufficient certainty to one of skill in the art to afford
22 clear notice of what is claimed and what is still open to the public. *See Biosig Instruments,*
23 *Inc. v. Nautilus, Inc.*, 738 F.3d 1374, 1378 (Fed. Cir. 2015) ("When a 'word of degree' is
24 used, the court must determine whether the patent provides 'some standard for measuring
25 that degree.'"); *Interval Licensing LLC v. AOL, Inc.*, 766 F.3d 1364, 1370 (Fed. Cir. 2014)
26 (the definiteness standard must allow for a modicum of uncertainty but must also require
27 clear notice of what is claimed thereby apprising the public of what is still open to them).
28

1 Finjan's contention that the claim term "Downloadable" cannot be indefinite simply
2 because the Court was able to construe it by adopting the explicit definition provided by
3 the inventor in the '520 patent fails to address the issue raised by ESET. A defined term is
4 still indefinite if a person of ordinary skill in the art cannot translate the definition into
5 meaningfully precise claim scope. *Halliburton Energy Servs., Inc. v. M-I LLC*, 514 F.3d
6 1244, 1251 (Fed. Cir. 2008). The issue therefore is whether a skilled artisan in 1997 would
7 have understood with reasonable certainty based on the specification and prosecution
8 history what the inventor meant by a "small" application program and therefore understood
9 what comes within the scope of the claims.

10 The '510 patent, incorporated into all the later patents, describes a Downloadable as
11 an "applet," a small interpretable or executable application program, and provides that "a
12 Downloadable is used in a distributed environment such as the Java™ distributed
13 environment produced by Sun Microsystems or in the Active X™ distributed environment
14 produced by Microsoft Corporation." See '520 Patent, at Col. 1:31-32, 34-38. Because
15 such examples existed in the 1990s, there should be an objective standard for the size of a
16 "small" program. While "absolute or mathematical precision" was not required, some
17 objective boundary should be identifiable from the disclosed embodiments. See *Biosig
18 Instruments*, 738 F.3d at 1381.

19 Finjan opposed ESET's initial motion for summary judgment for indefiniteness as
20 to the scope of "small" on the grounds that a numerical limitation or cut-off is not necessary
21 because a skilled artisan could determine if an application is "small" from the examples in
22 the '962 patent and based on the context. Finjan, however, did not provide an explanation
23 as to how that skilled artisan would therefore interpret "small" or the context that would
24 apply. [Doc. No. 610, at 8 and 15.]²

25
26
27 ² Finjan has also argued that the Court should reconsider its incorporation of "small" into the construction
28 of Downloadable and disregard that modifier as other district courts have done to avoid this definiteness
issue. [Doc. No. 812, at 6.] This solution may resolve Finjan's problem with defining "small," but the fact
that the Court's construction results in indefiniteness is not a basis for reconsideration.

1 ESET argued then, as it does now, that Finjan's experts did not provide any objective
2 boundaries for a "small" application program based on what a skilled artisan would have
3 understood was upper end of "small" in the context of application programs being
4 downloaded from a source computer to run on a destination computer at the time the
5 application was filed. [Doc. No. 816, at 5.] Finjan's contention that the understanding of
6 what is "small" depends on the context is not supported by the intrinsic evidence or even
7 extrinsic evidence of the state of the art at the relevant time. It amounted to "unpredictable
8 vagaries of any one person's opinion" and therefore failed to provide sufficient notice as
9 to the scope of the term. *Interval Licensing*, 766 F.3d at 1371 ("[A] term of degree fails to
10 provide sufficient notice of its scope if it depends on the unpredictable vagaries of any one
11 persons' opinion.")

12 ESET contends that the trial testimony of Finjan expert Dr. Eric Cole did not remedy
13 this defect.³ Dr. Cole presented an explanation how a skilled artisan would interpret
14 "small" that was neither disclosed in his previous declaration to the Court (small meant "a
15 few megs ... something that is not multiple gigs or really large" [Doc. No. 806-1, at 17])
16 or anchored to the specification or prosecution history. Rather than providing a range of
17 application size that would have been construed as "small" by an artisan in 1997, Dr. Cole
18 testified on Finjan's behalf that an application would be understood to be small if it "did
19 not require installation" and opined that "small" depends not on size but on the function.
20 Dr. Cole testified that a small executable is an application that does not require installation
21 is "self-contained" and is "just running automatically" which is "typical if you go to any
22 website nowadays," whereas an executable that is not small "requires installation" and has
23 "a lot of shared libraries and dlls and other programs" in order to run. [Doc. No. 812, at
24 12.] Dr. Cole testified that regardless of time period, Internet speed and other factors related
25

26
27 ³ Although the trial was terminated early due to the pandemic, Dr. Cole's testimony was completed. Finjan
28 suggests that Dr. Cole's testimony at a future trial will replace his completed testimony, but a subsequent
trial is not an opportunity for Dr. Cole to change his opinions or supplement them with support he did not
provide on the record at the first trial. [Doc. No. 816, at 11.]

1 to capacity, what fits the criteria of “small” may change but this distinction (installed or
2 not installed) is constant. Dr. Cole did not however provide support from the specification,
3 the prosecution history, or from any extrinsic sources in the relevant time period, for this
4 new explanation that a skilled artisan in 1997 would understand “small” to be “uninstalled”
5 or “not requiring installation.”

6 In sum, Finjan never offered evidence of a reasonable range for the size of a small
7 executable or interpretable application program as understood by a skilled artisan in 1997
8 based on examples provided in the patent specification. Instead, Finjan elected at trial to
9 offer a new understanding without reference to the size of the application as the objective
10 boundary of a “small” application. Finjan’s new definition is not supported by the
11 specification or prosecution history. It may be convenient to support Finjan’s
12 infringement contentions against ESET’s accused devices, but Finjan’s new explanation
13 does not provide clear notice of what constitutes a “small executable or interpretable
14 application program.”

15 **IV. Conclusion**

16 For the foregoing reasons, the Court finds that the term “Downloadable” as used
17 in the patents at-issue is indefinite. Accordingly, it is hereby **ORDERED** that ESET’s
18 motion for summary judgment of invalidity of Finjan’s United States Patent Nos.
19 6,154,844; 6,804,780; 8,079,086; 9,189,621; and 9,219,755 for indefiniteness is
20 **GRANTED**.

21 It is **SO ORDERED**.

22 Dated: March 29, 2021



23
24 Hon. Cathy Ann Bencivengo
25 United States District Judge
26
27
28

EXHIBIT E

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IN THE UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA

FINJAN LLC,

Plaintiffs,

v.

ESET, LLC and ESET SPOL. S.R.O.,

Defendants.

Case No. 17-cv-0183 CAB (BGS)

**PLAINTIFF FINJAN LLC'S
MEMORANDUM OF POINTS AND
AUTHORITIES IN SUPPORT OF ITS
MOTION FOR RECONSIDERATION**

PER CHAMBERS RULES, NO ORAL
ARGUMENT UNLESS SEPARATELY
ORDERED BY THE COURT

Date: May 17, 2021

Courtroom: 15A

Judge: Hon. Cathy Ann Bencivengo

AND RELATED COUNTERCLAIMS

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I. INTRODUCTION

In the context of a renewed motion for summary judgment following a mistral due to the COVID-19 pandemic—in which neither party completed its presentation of witnesses and evidence regarding patent infringement, and Defendants did not even begin their case in chief on invalidity—the Court made critical rulings on indefiniteness regarding U.S. Patents Nos. 6,154,844; 6,804,780; 8,079,086; 9,189,621; and 9,219,755 (“the Asserted Patents”).¹ (Doc. No. 869 (the “Order”).)

Finjan LLC (“Finjan”) respectfully requests the Court to reconsider the Order because (1) there is clear error in requiring Finjan to produce evidence to establish the Asserted Patents are valid—the burden falls squarely on Defendants to prove the contrary; and (2) there is clear error in holding that Finjan did not offer evidence of a range for the size of a “small” executable or interpretable application program, as understood by one of skill in the art in 1997 and based on examples provided in the patent specifications. (*See* Order at 8.)

First, respectfully, the Court’s holding is incorrect as a matter of law. Based on a single word in the Court’s claim construction—namely the word “small”—Defendants ESET, LLC and ESET SPOL. S.R.O. (together, “ESET”) have argued the Asserted Patents are indefinite, thus rendering them invalid. Accordingly, ESET—not Finjan—has the burden of proof to show by clear and convincing evidence that the claims fail to satisfy the definiteness requirement under 35 U.S.C. § 112. *See, e.g., Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 912 (2014). ESET did not meet this burden and indeed had not even begun its invalidity case when the trial was halted due to the pandemic.

¹ The Court issued an original Order on March 23, 2021 on Defendants’ Renewed Motion for Summary Judgment on Indefiniteness. (*See* Doc. No. 864.) The Court issued an Amended Order on March 29, 2021. (Doc. No. 869.)

Second, the Court’s holding ignores critical issues of fact. The finding of indefiniteness is based on an incomplete presentation of the evidence because the Court evaluated only the testimony of Dr. Eric Cole, Finjan’s expert on infringement on one of the five Asserted Patents (the ’844 Patent). The Court did not and could not account for the testimony of Finjan’s expert on validity, Dr. Goodrich, who—but for the mistrial—would have explained how a person of ordinary skill in the art (“POSITA”) would understand the objective bounds of the claim term “downloadable,” based on teachings from the patent specification. (*See generally* Finjan’s Offer of Proof, filed concurrently herewith.) Moreover, ESET’s expert, Dr. Eugene Spafford, who opined on the scope of the claims for purposes of both non-infringement and invalidity—and critically offered no opinion on any alleged indefiniteness of the term “downloadable”—also was not presented or cross-examined at trial. Accordingly, the Court should reconsider its Order in light of the incomplete factual record and expert testimony that precludes summary judgment.

II. PROCEDURAL BACKGROUND

On April 23, 2019, ESET filed a motion for summary judgment of invalidity due to indefiniteness based on the Court’s construction of the term, “downloadable.” (*See* Doc. No. 478-1.) The Court heard argument and denied the motion without prejudice, finding that there were factual disputes regarding what a POSITA in 1997 would have understood constituted a “small” downloadable, based on the Court’s construction.² (Doc. No. 699.)

A jury trial commenced on March 10, 2020, but was halted shortly thereafter due to the COVID-19 pandemic. The Court excused the jury and declared a mistrial. (*See* Doc. No. 783.) On August 21, ESET filed its renewed motion for summary

² Finjan understands that the Court’s construction of the term “downloadable,” which includes the word “small,” is final. To be clear, Finjan maintains its objection to the construction.

1 judgment on indefiniteness. (Doc. No. 806.) The Court allowed ESET to renew its
2 motion because it had heard testimony from one of Finjan’s experts, Dr. Cole,
3 regarding what a “small” downloadable was at trial. The specific issue before the
4 Court on the renewed motion was whether a POSITA in 1997 would have understood
5 with reasonable certainty, based on the specification and prosecution history, what
6 was meant by the scope of not just any downloadable, but one that was “small.” (Doc.
7 No. 869 at 6.) After reviewing the renewed motion and related briefing, the Court
8 issued its Order, holding that Finjan “never offered evidence of a reasonable range for
9 the size of a small executable or interpretable application program as understood by a
10 skilled artisan in 1997 based on examples provided in the patent specification.” (Doc.
11 No. 869 at 8.) The Court did so without hearing all the evidence and testimony for
12 all Asserted Patents regarding what a POSITA would understand a “small”
13 downloadable to mean in the context of the various patents. Soon thereafter, the Court
14 entered an order to sever and stay the litigation of the ’305 Patent (Doc. No. 871), and
15 granted Finjan the opportunity to file this motion for reconsideration (Doc. No. 870).

16 **III. LEGAL STANDARDS**

17 **A. Motions for Reconsideration**

18 Reconsideration of a prior order “is appropriate if the district court (1) is
19 presented with newly discovered evidence, (2) committed clear error or the initial
20 decision was manifestly unjust, or (3) if there is an intervening change in controlling
21 law.” *Sch. Dist. No. 1J, Multnomah Cty., Or. v. ACandS, Inc.*, 5 F.3d 1255, 1263 (9th
22 Cir. 1993). It is respectfully submitted that in shifting the burden of proof to Finjan
23 to prove the term “small” is not indefinite and in deciding the motion on an incomplete
24 record, the Court committed clear error and the Court’s decision is manifestly unjust.

25 **B. Summary Judgment**

26 “In the context of a motion for summary judgment, the Court must not weigh
27 the credibility of the evidence and determine the truth of the matter.” *Finjan, Inc. v.*
28 *ESET, LLC*, 2019 WL 7290961, at *1 (S.D. Cal. Dec. 30, 2019) (citing *Anderson v.*

1 *Liberty Lobby, Inc.*, 477 U.S. 242, 249 (1986)). Further, the non-movant’s evidence
2 is to be believed and all justifiable inferences are to be drawn in the non-movant’s
3 favor. *Id.* In its Order, the Court clearly weighed the credibility of Dr. Cole and did
4 not draw all reasonable inferences in favor of Finjan, the non-moving party. (Doc.
5 No. 869 at 7-8.)

6 **C. Indefiniteness**

7 Section 112 requires that a patent specification “conclude with one or more
8 claims particularly pointing out and distinctly claiming the subject matter which the
9 applicant regards as his invention.” *Sonix Tech. Co. v. Publications Int’l, Ltd.*, 844
10 F.3d 1370, 1377 (Fed. Cir. 2017). The Supreme Court has read this provision to
11 require that “a patent’s claims, viewed in light of the specification and prosecution
12 history, inform those skilled in the art about the scope of the invention with reasonable
13 certainty.” *Id.* (citing *Nautilus*, 572 U.S. at 910). Indefiniteness must be proven by
14 clear and convincing evidence. *Sonix Tech. Co.*, 844 F.3d at 1377. “The certainty
15 which the law requires in patents is not greater than is reasonable, having regard to
16 their subject-matter,” and the inquiry “trains on the understanding of a skilled artisan
17 at the time of the patent application.” *Nautilus*, 572 U.S. at 899, 910-11. “Because
18 language is limited,” the Federal Circuit has “rejected the proposition that claims
19 involving terms of degree are inherently indefinite.” *Sonix Tech. Co.*, 844 F.3d at
20 1377. Thus, “a patentee need not define his invention with mathematical precision in
21 order to comply with the definiteness requirement,” so long as it provides “enough
22 certainty to one of skill in the art when read in the context of the invention.” *Id.*
23 (internal citation omitted).

24 Following Supreme Court and Federal Circuit precedent, this Court has held
25 that terms of degree are not indefinite. For example, “words of degree — such as
26 ‘substantially’ — are not considered indefinite so long as intrinsic evidence ‘provides
27 objective boundaries for those of skill in the art.’” *Bell N. Rsch., LLC v. Coolpad*
28 *Techs., Inc.*, 2019 WL 3766688, at *2 (S.D. Cal. Aug. 9, 2019) (citing *Interval*

1 *Licensing LLC v. AOL, Inc.*, 766 F.3d 1364, 1370-71 (Fed. Cir. 2014)). Had the trial
2 been completed in this case, the Court would have had more than sufficient evidence
3 to find that the term “small” did not render the claims indefinite.

4 **D. Offer of Proof**

5 “A proper offer of proof informs the trial court of what counsel expects to prove
6 by the excluded evidence and preserves the record so that an appellate court can
7 review the trial court’s decision for reversible error.” *See Heyne v. Caruso*, 69 F.3d
8 1475, 1481 (9th Cir. 1995). In this case while evidence was not actually excluded
9 due to the mistrial, the evidence had yet to be presented. Therefore, concurrently with
10 this filing, Finjan is presenting the Court with evidence of what the Court would have
11 heard had the trial been completed, pursuant to Fed. R. Evid. 103(a).

12 **IV. ARGUMENT**

13 Respectfully, the Court’s Order is incorrect as a matter of law and fact. **First**,
14 the Court’s holding was clearly erroneous as a matter of law because it improperly
15 shifted the burden to Finjan to prove patent validity. The Court’s Order focused on
16 how Finjan “did not provide an explanation as to how that skilled artisan would
17 interpret ‘small’ or the context in which it would apply.” (Order at 6.)

18 However, Finjan does not have a burden to prove that the claims are not
19 indefinite. As this Court properly held in its October 2019 Order Denying ESET’s
20 Motions for Summary Judgment and Motions to Exclude or Strike (Doc. No. 699 at
21 6), “ESET has the burden of proving indefiniteness by clear and convincing
22 evidence.” (Doc. No. 699 at 6) (citing *Biosig Instruments, Inc. v. Nautilus, Inc.*, 783
23 F.3d 1374, 1377 (Fed. Cir. 2015)). Thus, as a matter of law, it is, and always has been
24 ESET’s burden to prove by clear and convincing evidence that the “patent’s claims,
25 viewed in light of the specification and the prosecution history,” would not “inform
26 those skilled in the art about the scope of the invention with reasonable certainty.”
27 *Nautilus Inc.*, 572 U.S. at 910. It is not Finjan’s burden to prove the contrary.

28 Notably, ESET’s expert on invalidity, Dr. Spafford, had no difficulty offering

1 an opinion on the scope of the claims for non-infringement and invalidity—though he
2 offered no opinion on indefiniteness on the Court’s definition of “downloadable”—
3 in his expert reports or deposition testimony. In his expert report on invalidity, Dr.
4 Spafford gave multiple examples of his understanding of the application of the
5 defined term, “downloadable,” and specifically what “small” meant in light of the
6 intrinsic record to a POSITA at the time of the alleged invention. For example, in his
7 expert report, Dr. Spafford explained:

8
9 “An applet typically is a **small program** residing on a
10 server . . .” (Williams Decl.³ Exh. 1 (Spafford Inv. Rpt., Ex.
B-1) at p. 3 (emphasis added).)

11
12 “. . . a computing device (e.g., first computer 210, third
13 computer, etc.) can download “[a]pplets, which are **small**
14 **programs** compiled to an intermediate form.” (Williams
Decl. Exh. 2 (Spafford Inv. Rpt., Ex. A-3) at p. 16
(emphasis added).)

15
16 “. . . one ordinarily skilled in the art at the time of the alleged
17 invention: ‘a **small application program** that can be called
18 up for use while working in another application.’”
(Williams Decl. Exh. 3 (Spafford Inv. Rpt., Ex. D-1) at p.
13 (emphasis added).)

19
20 “A person of ordinary skill in the art would have understood
21 that . . . any form of executable, to Java applications/code
22 as specifically referenced, and other form of **small**
23 **applications** as well. . . .” (Williams Decl. Exh. 4 (Spafford
Inv. Rpt., Ex. D-6) at p. 11 (emphasis added).)

24 Indeed, Dr. Spafford’s opening invalidity report does not even include as an
25 alternative analysis that the term “downloadable” as construed is indefinite, rendering

26
27 ³ All Exhibits (“Exh.”) referenced herein are attached to the accompanying
28 Declaration of K. Nicole Williams.

the claims invalid.

Moreover, at his March 2019 deposition, Dr. Spafford, testified to his understanding of what would constitute a downloadable under the Court’s construction, and at no point during his deposition did he offer that the claim term was indefinite, much less explain why he thought so. For example, Dr. Spafford provided explanations as to why specific examples (such as HTML web pages, PDFs, JavaScript) would constitute a downloadable under the Court’s construction of the term. (*See* Williams Decl. Exh. 5 (2019-03-13 Spafford Dep.) at 147:10-150:13.) And, Dr. Spafford presented no testimony at trial, as Finjan’s affirmative presentation of infringement evidence was interrupted by the mistrial and Defendants’ rebuttal and affirmative invalidity case had not begun.

Further, also due to the mistrial, Finjan’s rebuttal expert, Dr. Michael Goodrich, did not present his rebuttal opinion regarding validity to rebut Dr. Spafford’s opinions or confirm the scope of the Court’s definition of “downloadable.” With no trial testimony from either expert on validity, ESET could not have met its burden to prove by clear and convincing evidence that the patent claims, viewed in light of the specification and prosecution history, do not inform those skilled in the art about the scope of the invention under *Nautilus*. Because the Court’s holding shifted the burden to Finjan and relied solely on expert testimony from one of Finjan’s experts on infringement (who was not one of Finjan’s two experts on invalidity), it is clearly erroneous as a matter of law.

Second, the Court’s holding is clearly erroneous as a matter of fact when the Court states that “Finjan *never* offered evidence of a reasonable range for the size of a small executable or interpretable application program as understood by a skilled artisan in 1997 based on examples provided in the patent specification.” (Order at 8 (emphasis added).) Finjan was still in its case in chief on infringement when a mistrial was declared. One of Finjan’s infringement experts, Dr. Michael Mitzenmacher, was in the middle of his testimony when the trial came to a halt. Another of Finjan’s

1 infringement experts, Dr. Nenad Medvidovic was waiting to testify about
2 infringement of the remaining patents, and two other Finjan experts, Dr. Trent Jaeger
3 and Dr. Michael Goodrich, were waiting to testify about validity.⁴ Had trial
4 continued, Finjan would have offered evidence of what a POSITA would have viewed
5 as a reasonable range for the size of a small executable or interpretable application
6 program. Finjan also would have elicited testimony on cross-examination of ESET's
7 invalidity expert Dr. Spafford that he *never* opined that the term "small" renders the
8 claims indefinite. This fact alone is significant and was one of the factors the Federal
9 Circuit, in *Sonix*, considered in reversing the district court's invalidity finding due to
10 indefiniteness. *Sonix*, 844 F.3d at 1390 ("Appellees' own expert, also did not opine
11 that the claims were indefinite or that a skilled artisan would not have understood the
12 term. . .").

13 Finjan would have further established during cross-examination that
14 Dr. Spafford was one of skill in the art and that he understood what the term "small"
15 meant when viewed in light of the specification and prosecution history, as confirmed
16 by his infringement and validity opinions relating to the subject limitations. Finjan
17 would have done this by establishing that Dr. Spafford gave multiple examples in his
18 expert report of what the term "small" meant in relation to the claims. (*See, e.g.*,
19 Williams Decl. Exh. 1 (Spafford Inv. Rpt., Ex. B-1) at p. 3; Williams Decl. Exh. 2
20 (Spafford Inv. Rpt., Ex. A-3) at p. 16; Williams Decl. Exh. 3 (Spafford Inv. Rpt., Ex.
21 D-1) at p. 13; Williams Decl. Exh. 4, (Spafford Inv. Rpt., Ex. D-6) at p. 11 (emphasis
22 added).) Finjan also would have cross-examined Dr. Spafford to establish that all the
23 examples Dr. Spafford identified as meeting the Court's definition of downloadable
24 are the same examples that appear in the specifications of the Asserted Patents, *see*,
25 *e.g.*, '844 Patent, 1:45-56; '780 Patent, 1:55-61; '086 Patent, 2:2-6; '621 Patent, 3:2-

26
27 ⁴ Finjan's Offer of Proof, filed concurrently with this Motion, provides an overview
28 of what these experts would have testified at trial, but for the mistrial.

7; '755 Patent, 2:33-37. Thus, at the conclusion of ESET's case, Finjan would have moved for JMOL that ESET, the party with the burden of proof, had failed to prove by clear and convincing evidence that the term "small" rendered the claims indefinite.

Had the Court denied the JMOL or taken it under submission, Finjan would have called, at a minimum, Dr. Goodrich in rebuttal. Dr. Goodrich—who had not testified at all at the time of the mistrial—would have testified consistent with his deposition testimony that, while small is a relative term, it will "always be clear from the context" to one of skill in the art whether something qualifies "as small or not. . ." (Williams Decl. Exh. 6 (excerpts from March 1, 2019 Goodrich Dep.) at 101:8-108:14.)⁵ Dr. Goodrich, again consistent with his deposition testimony, would have given specific examples from the prior art:

Q. So if one skilled in the art were to pick up a 621 patent or 755 patent, how would they determine what qualifies as a downloadable?

A. So the specification of the 962 patent, for example, gives several examples of this that would be easily discernible by a person of ordinary skill in the art.

So, for example, reading from column 1, starting at line 39, it states, "A downloadable is a **small** executable or interpretable application program which is downloaded from a source computer and run on a destination computer. **A downloadable is used in a distributed environment,**

⁵ Moreover, both Finjan's and ESET's examples of a "small" downloadable do not include programs that require installers, consistent with Dr. Cole's testimony at trial. (See Doc. No. 812-1 (Wells Ex. 2 (Cole Trial Tr.) at 314:5-333:3).) And while Dr. Cole testified about a narrow question on the physical size of a non-installed executable, he was not asked whether this was consistent with the claim scope as a whole, and even noted that such an example was "extremely unusual." (*Id.* (Cole Trial Tr.) at 464:17-22.)

1 **such as in the Java distributed environment produced**
2 **by Sun Micro Systems or in the ActiveX distributed**
3 **environment produced by Microsoft Corporation.”**

4 And so we already see from that and the further readings
5 that occur after that in the specification, that **examples of**
6 **downloadable from the specification itself include Java**
7 **applets and ActiveX controls.** And it even has, like,
8 Figures 4 and 3 that get into the details of the whole
9 architecture surrounding those downloadables.

10 (Williams Decl. Exh. 6 (excerpts from March 1, 2019 Goodrich Dep.) at 104:3-105:1.)
11 As described above, Finjan would have already established, through the cross-
12 examination of Dr. Spafford, that these examples of “small” executables or
13 interpretable application programs in the prior art are the same examples found in the
14 specifications of the ’844, ’780, ’086, ’621, and ’755 Patents. Drs. Spafford’s and
15 Goodrich’s testimony alone would have raised a triable issue of fact as to whether the
16 term “small” renders the claim term “downloadable” indefinite.

17 Viewing the testimony that would have been elicited from Dr. Spafford and
18 provided by Dr. Goodrich in the light most favorable to Finjan, the non-moving party,
19 the Court should reconsider its holding, and find that there is a genuine dispute of
20 material fact that precludes summary judgment on indefiniteness, especially where all
21 the evidence was not presented due to the mistrial. *See, e.g., Whitewater W. Indus.,*
22 *Ltd. v. Pac. Surf Designs, Inc.*, 2019 WL 4452986, at *19 (S.D. Cal. Sept. 16, 2019)
23 (citing *Garter-Bare Co. v. Munsingwear, Inc.*, 650 F.2d 975, 979-82 (9th Cir. 1980)
24 (reversing a district court’s grant of summary judgment where the parties provided
25 conflicting expert testimony, but the district court granted summary judgment by
26 relying solely on one party’s expert testimony)); *see also Sonix*, 844 F.3d at 1381
27 (“The examiner’s knowing allowance of claims based on the term that is now
28 questioned, plus the acceptance of the term by both parties’ experts, force us to the
29 conclusion that the term ‘visually negligible’ is not indefinite.”).

Third, the law is clear that simply because a term is relative does not mean it is indefinite. As described above, in *Sonix*: “[b]ecause language is limited, we have rejected the proposition that claims involving terms of degree are inherently indefinite.” *Sonix*, 844 F.3d at 1377 (citing *Interval Licensing*, 766 F.3d at 1370). Thus, “a patentee need not define his invention with mathematical precision in order to comply with the definiteness requirement.” *Invitrogen Corp. v. Biocrest Mfg., L.P.*, 424 F.3d 1374, 1384 (Fed. Cir. 2005) (citation omitted). Indeed, “[c]laim language employing terms of degree has long been found definite where it provided enough certainty to one of skill in the art when read in the context of the invention.” *Interval Licensing*, 766 F.3d at 1370 (citation omitted). Here, Dr. Goodrich explains that while context matters given that “small” is a relative term, a POSITA in 1997, would understand that Java applets or Active X controls would constitute downloadables, in light of their small size in comparison to the execution environment, such as the Internet browser. Thus, Dr. Goodrich would have opined on the upper and lower bounds of the term small in the context of the Court’s claim construction. (*See, e.g.*, Williams Decl. Exh. 6 (excerpts from March 1, 2019 Goodrich Dep.) at 101:8-108:14)); (*see also* Williams Decl. Exh. 5 (2019-03-13 Spafford Dep.) at 147:10-150:13 (Spafford testimony providing examples of a “downloadable” under the Court’s construction).)

Fourth, Finjan anticipates that ESET will argue that the offer of proof regarding Dr. Goodrich is based solely on his deposition testimony and not his expert report. However, it is important to note that the indefiniteness argument was not raised as part of ESET’s invalidity contentions under Patent L.R. 3-3(d), nor was it raised in ESET’s expert opening report on invalidity, or the Pretrial Order. Dr. Goodrich’s report was prepared in rebuttal to the opinions in Dr. Spafford’s invalidity report and, as discussed above, Dr. Spafford’s report was devoid of any reference to the term “small” rendering the claims indefinite. It was only when asked

1 at his deposition about what he, Dr. Goodrich, thought “small” meant, that
2 Dr. Goodrich was able to expound upon that issue.

3 **V. CONCLUSION**

4 For the foregoing reasons, Finjan respectfully requests the Court reconsider the
5 Order and deny ESET’s Renewed Motion for Summary Judgment for Indefiniteness.

6
7 DATED: April 12, 2021

Respectfully Submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the above and foregoing document has been served on April 12, 2021, to all counsel of record who are deemed to have consented to electronic service via the Court's CM/ECF system per Civil Local Rule 5.4. Any other counsel of record will be served by electronic mail, facsimile and/or overnight delivery.

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IN THE UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA

FINJAN LLC,

Plaintiffs,

v.

ESET, LLC and ESET SPOL. S.R.O.,

Defendants.

AND RELATED COUNTERCLAIMS

Case No. 17-cv-0183 CAB (BGS)

**FINJAN LLC'S OFFER OF PROOF
RE OPINIONS OF FINJAN'S
VALIDITY AND INFRINGEMENT
EXPERTS**

District Judge: Hon. Cathy Ann
Bencivengo
Magistrate Judge: Hon. Bernard G.
Skomal

1 In view of the Court’s Amended Order on Defendants’ Renewed Motion for
2 Summary Judgment (Doc. No. 869), and pursuant to Fed. R. Evid. 103(a)(2), Finjan
3 LLC (“Finjan”) respectfully submits the following offer of proof in support of
4 Finjan’s Motion for Reconsideration of the Order on Defendants’ Renewed Motion
5 for Summary Judgment, filed concurrently herewith. But for the mistrial due to the
6 COVID-19 pandemic and the issuance of the State of California’s stay-home order
7 (Doc. No. 783), Finjan would have called its expert witnesses, including, Drs. Michael
8 T. Goodrich, Nenad Medvidovic, and Trent Jaeger to describe how one of skill in the
9 art in 1997 would understand the term, “downloadable,” and specifically, what is a
10 reasonable range for the size of a “small” executable or interpretable application
11 program based on examples provided in the patent.

12 1. Dr. Michael T. Goodrich, Finjan’s expert regarding validity of U.S.
13 Patent Nos. 9,189,621 (“the ’621 Patent”), and 9,219,755 (“the ’755 Patent”), would
14 testify as to his understanding of “small,” in the context of the Court’s construction
15 for the claim term, “downloadable.” (*See, e.g.*, Williams Decl. Exh. 6 (excerpts from
16 March 1, 2019 Goodrich Dep.) at 101:8-108:14.)¹ Specifically, Dr. Goodrich would
17 testify that “small” is “a relative term, so it depends on the context. So if we’re talking
18 about a context that is dealing with things that are identified as small as being, let’s
19 say, on the order of, you know, 5, 10 kilobytes, then something on the order of
20 gigabytes would be an example of something that’s not small in that context.” (*Id.* at
21 102:14-22.)

22 2. Dr. Goodrich would testify, consistent with his March 1, 2019 deposition
23 testimony, about examples of a “small” downloadable, in the context of the patents-
24 in-suit:

25 Q. And the context you’re referring to is the context of 621
26 and 755 patents; right?

27 ¹ All Exhibits (“Exh.”) referenced herein are attached to the accompanying
28 Declaration of K. Nicole Williams.

1 A. Yes. Because, again, small is a relative term. So it also
2 depends on now what is, you know, a specific instance of,
3 you know, preferred embodiment, let's say, or looking at
4 prior art references. That's -- that's the way I applied that
5 claim language to understand small, and that's relative
6 context.

7 Q. Is Internet Explorer a downloadable as considered by the
8 court?

9 A. Do you have a context for that, like in a prior reference
10 that you're talking about? Because, again, it's always
11 relative, so is it -- when you say "Internet Explorer,"
12 compared to what?

13 Q. In the context of these patents.

14 A. So it's -- it's possible that it could be an executable or not
15 -- I mean the downloadable or not, depending on what it's
16 being compared to. Small is a relative term, so you have to
17 compare it to something. So just in the isolation, one
18 product could be small or could be large, depending on what
19 you're comparing it to.

20 Q. How does one know if it qualifies as small or not if
21 it's a relative term?

22 A. Because that will always be clear from the context. I
23 mean, if we could talk about any of the prior art references,
24 and I could tell you, in my opinion, whether or not things
25 that Dr. Spafford has identified as downloadables qualify as
26 being small.

27 Q. So if one skilled in the art were to pick up a 621 patent
28 or 755 patent, how would they determine what qualifies as
a downloadable?

1 A. So the specification of the 962 patent, for example,
2 gives several examples of this that would be easily
3 discernible by a person of ordinary skill in the art.

4 So, for example, reading from column 1, starting at line
5 39, it states, "A downloadable is a small executable or
6 interpretable application program which is downloaded
7 from a source computer and run on a destination
8 computer. A downloadable is used in a distributed
9 environment, such as in the Java distributed
10 environment produced by Sun Micro Systems or in the
11 ActiveX distributed environment produced by
12 Microsoft Corporation.

13 And so we already see from that and the further
14 readings that occur after that in the specification, that
15 examples of downloadable from the specification itself
16 include Java applets and ActiveX controls. And it even
17 has, like, Figures 4 and 3 that get into the details of the
18 whole architecture surrounding those downloadables.

19 Q. With your understanding of what downloadable means
20 in the context of these patents, would Internet Explorer
21 qualify as a downloadable?

22 A. Again, it depends on what it's being compared to. So in
23 this case, the Java applets and ActiveX controls are the
24 downloadables, and the browser that they would be
25 executing on is a part of their execution environment. It may
26 be in some other context, it might make a difference. **But**
27 **here in this, compared to these little applets and little**
28 **ActiveX controls, those are the downloadables, not the**
Internet Explorer. But there might be another context
where that would be counted as a downloadable. Depends
on a lot of details. It has to fulfill the court's claim
construction for what is a downloadable. That's the bottom
line.

...

1 **Q. In 1996, what would be considered a downloadable**
2 **as construed by the court?**

3 ...

4 **A. So the 639 application has examples that are the same**
5 **examples : Java applets and ActiveX controls. And this**
6 **is from 1996.**

7 **Q. In 2017, what would be considered a downloadable**
8 **as construed by the court?**

9 ...

10 **A. In 2017 I would apply the same court’s construction**
11 **namely, a small executable or interpretable application**
12 **program which is downloaded from a source computer**
13 **and run on a destination computer. So those same things**
14 **would still be examples of that, but there may be others**
15 **that would satisfy that claim construction.**

16 (Williams Decl. Exh. 6 (excerpts from March 1, 2019 Goodrich Dep.) at
17 102:23-107:18 (emphasis added).)

18 3. Dr. Nenad Medvidovic, Finjan’s expert regarding infringement of U.S.
19 Patent Nos. 9,189,621 (“the ’621 Patent”) and 9,219,755 (“the ’755 Patent”), would
20 testify, consistent with his February 27, 2019 deposition testimony, as to his
21 understanding of “small” in the context of the Court’s construction for the claim term
22 “downloadable”:

23 **Q. Is Internet Explorer a downloadable?**

24 **A. Internet Explorer would fall afoul, at least of the**
25 **small limitation in the definition, ‘cause it’s really large.**

26 **Q. Is Microsoft Word a downloadable?**

27 **A. Not in the sense in which this term is construed.**
28

Q. Is Microsoft PowerPoint a downloadable?

A. I -- you know, we can short-circuit this. I don't think that any of the Office products are small so that you could consider them a small executable.

(Williams Exh. 7 (excerpts from February 27, 2019 Medvidovic Dep.) at 116:2-11 (emphasis added).)

4. Dr. Trent Jaeger, Finjan's expert regarding validity of U.S. Patent Nos. 6,804,780 ("the '780 patent"); 8,079,086 ("the '086 Patent"); and 6,154,844 ("the '844 Patent"), would have testified about his understanding of the term "small" consistent with his rebuttal expert report where he discusses exemplary instances of files that are not "small" executables or interpretable application programs, within the bounds of the Court's construction. This demonstrates that, had Dr. Jaeger had the opportunity to testify at trial, he would have been prepared to testify on what constitutes a "small" executable, including opining on the upper and lower bounds of the term small in the context of the Court's claim construction. For example, Dr. Jaeger would have testified that "[a] mail database and plain mail files are not downloadables because they are not 'a small executable or interpretable application program which is downloaded from a source computer and run on a destination computer.'" (Williams Decl. Exh. 8 (Jaeger Reb. Rep.) at ¶ 1101.)

5. In addition, but for the mistrial, Finjan would have cross-examined Defendants' invalidity expert, Dr. Eugene Spafford. Through cross-examination Finjan would have demonstrated that Dr. Spafford never opined that the term "small" rendered the claims indefinite. Finjan would have established that Dr. Spafford had given multiple examples of the meaning of the term "small" in the context of the Court's claim construction. For example, in addition to his expert report, Dr. Spafford

1 provided his understanding of the term “downloadable,” in the context of the Court’s
2 construction, during his March 2019 deposition:

3 Q. Do you agree that a Downloadable can be an HTML web
4 page?

5 A. So if we go back to Court construction, Court claim
6 construction, a Downloadable is “a small executable or
7 interpretable application program which is downloaded
8 from a source computer and run on a destination
9 computer.” I do not view HTML as an application
10 program.

11 Q. When you say, “I do not view HTML as an
12 application program,” are you saying that HTML code
13 cannot be a Downloadable?

14 ...

15 A. The Court’s construction of an “executable or
16 interpretable application program”; I do not view an
17 HTML file, a generic HTML file as an application
18 program.

19 Q. Can any HTMLs be a Downloadable?

20 A. HTML can be used to transmit JavaScript, Java,
21 which are executables.

22 Q So if HTML includes JavaScript, it can be a
23 Downloadable?

24 A. Those can be Downloadables. Not the HTML, but the
25 scripts. Those are application programs.

26 Q. So is there any case in which HTML can be a
27 Downloadable?

28 A. HTML is a rendering language that describes how to
display items on the screen. It's not an application program.

1 So I would not -- I view it as a script but not as an
2 application program.

3 **Q. So in your opinion, HTML cannot be a**
4 **Downloadable; correct?**

5 **A. I would not interpret it as such.**

6 **Q. Can Java outputs be a Downloadable?**

7 **A. Yes.**

8 **Q. You stated that JavaScript can be a Downloadable**
9 **too?**

10 **A. Yes.**

11 **Q. And ActiveX can be a Downloadable too?**

12 **A. Yes. Capital A, capital X.**

13 **Q. Can PDF be a Downloadable?**

14 **A. A PDF file, again, is a display language. PDFs don't**
15 **– aren't application programs, so I wouldn't see a PDF**
16 **as an application program.**

17 ...

18 **Q. Does a PDF with JavaScript qualify as a**
19 **Downloadable?**

20 **A. As I said, a PDF is a page description form. If it**
21 **contains JavaScript, the JavaScript can certainly be a**
22 **Downloadable.**

23 **Q. So in the case where there's a PDF containing JavaScript,**
24 **only the JavaScript is considered Downloadable but the**
25 **PDF is not?**

1 A. That's how I would consider it, given the Court's
2 instruction.

3 Q This is because PDF does not contain any executable
4 code; is that correct?

5 A. PDF, yeah, is not an executable.

6 Q. Does PDF include any executable code?

7
8 A. It may.

9 Q. So if a PDF includes executable code, would that qualify as a
10 Downloadable?

11 A. It would not be an application program.

12 Q Why is that?

13
14 A. Because it wouldn't be executed. It may contain an executable
15 component.

16 (Williams Decl. Exh. 5 (excerpts from March 13, 2019 Spafford Dep.) at 147:10-
17 150:13 (emphasis added).)

18 6. In sum, had trial not been vacated due to the COVID-19 pandemic,
19 Finjan would have offered evidence and testimony from the aforementioned
20 witnesses, consistent with their expert reports and depositions regarding the
21 reasonable range for the size of a "small" downloadable, from the perspective of one
22 of skill in the art in 1997, based on examples provided in the patent specifications.

1 DATED: April 12, 2021

Respectfully Submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the above and foregoing document has been served on April 12, 2021, to all counsel of record who are deemed to have consented to electronic service via the Court's CM/ECF system per Civil Local Rule 5.4. Any other counsel of record will be served by electronic mail, facsimile and/or overnight delivery.

/s/ Juanita R. Brooks
Juanita R. Brooks

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
(SAN JOSE DIVISION)

FINJAN LLC, a Delaware Limited Liability
Company,

Plaintiff,

v.

CISCO SYSTEMS, INC., a California
Corporation,

Defendant.

Case No. 5:17-cv-00072-BLF

**[PROPOSED] ORDER DENYING CISCO
SYSTEM'S, INC.'S MOTION FOR
JUDGMENT OF INVALIDITY OF THE
'844, '780, AND '494 PATENTS BASED ON
COLLATERAL ESTOPPEL**

This matter comes before the Court on Cisco Systems, Inc.'s Motion for Judgment of Invalidity of the '844, '780, and '494 Patents Based on Collateral Estoppel. Upon consideration of all pleadings, papers, and arguments submitted in support and opposition, the Court orders as follows: IT IS HEREBY ORDERED that Cisco's Motion is DENIED.

IT IS SO ORDERED.

Dated: _____

Hon. Beth Labson Freeman
United States District Court

EXHIBIT C

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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA,
(SAN JOSE DIVISION)

FINJAN LLC, a Delaware Limited Liability
Company,

Plaintiff,

v.

CISCO SYSTEMS, INC., a California
Corporation,

Defendant.

Case No. 5:17-cv-00072-BLF-SVK

**CISCO SYSTEMS, INC.'S REPLY IN
SUPPORT OF ITS MOTION FOR
JUDGMENT OF INVALIDITY OF THE
'844, '780, AND '494 PATENTS BASED
ON COLLATERAL ESTOPPEL**

Finjan’s Opposition ignores controlling law on the collateral estoppel that results from the invalidation of a patent, and instead rests its argument on a recitation of historical facts that are legally irrelevant. Once a patent is found invalid, it is dead, and it cannot be asserted against any party, regardless of prior claim construction rulings or stipulations in a given case, and regardless of whether this Court would have reached the same conclusion on subsidiary issues. The same is true of any other patent that presents the identical “issue.”

Cisco files this reply to make four brief points.

First, the only one of the four factors in the collateral estoppel test that Finjan disputes regarding any of the three patents is the “final judgment” element, discussed below. Finjan does not dispute that under the Federal Circuit case law, the same “issue” exists on the ‘494 Patent as the already-invalidated ‘844 and ‘780 Patents, as set forth in Cisco’s Opening Brief. *See Ohio Willow Wood Co. v. Alps S., LLC*, 735 F.3d 1333, 1342 (Fed. Cir. 2013); *Nestlé USA, Inc. v. Steuben Foods, Inc.*, 884 F.3d 1350, 1351-52 (Fed. Cir. 2018); *Papst Licensing GMBH & Co. v. Samsung Elecs. Am., Inc.*, 924 F.3d 1243, 1252-53 (Fed. Cir. 2019); *Arunachalam v. Presidio Bank*, 801 F. App’x 750, 752-53 (Fed. Cir. 2020). Finjan makes no effort to distinguish the logic or outcome of these cases holding that it is the identity of the issues that determines whether collateral estoppel applies. Under the governing law, therefore, these patents all must rise (and now fall) together.

Second, as also set forth in Cisco’s Opening brief, it is irrelevant that this Court (and other Courts) previously construed the term “Downloadable” (including in the ‘494 Patent) differently than the construction that led to the invalidation of the five patents addressed in the ESET Order. The law is again clear that once a patent is found invalid, the only issue for decision in later cases is whether the test for collateral estoppel is met. Here, it unquestionably is. Finjan’s invitation for this Court to blaze a new trail because of Cisco’s prior positions in this case is wrong on the law, and has been rejected by other district courts. *Quest Integrity USA, LLC v. A.Hak Indus. Servs. US, LLC*, No. C14-1971-RAJ, 2017 U.S. Dist. LEXIS 119821, at *10-11 (W.D. Wash. July 31, 2017); *Crossroads Sys. (Tex.), Inc. v. Dot Hill Sys. Corp.*, 2006 WL 1544621, at *5 (W.D. Tex. May 31, 2006). Cisco laid these cases out in its Opening Brief, and Finjan has no answer.

1 Third, Finjan does not cite any case where a district court declined to apply collateral
 2 estoppel to the *invalidation* of a patent, where that prior ruling satisfies all four elements of the
 3 collateral estoppel test. Most of the cases on which Finjan relies for the proposition that a district
 4 court has the discretion to decline to apply collateral estoppel are not even patent cases, and none
 5 is a patent case in which a patent has been found invalid. If a district court had the discretion to
 6 ignore the death of patent in an invalidity ruling, then the Federal Circuit could not have reversed
 7 the district court’s failure to apply collateral estoppel in *Mendenhall*. 26 F.3d 1573 at 1579-80.
 8 Likewise, Finjan cannot rewrite the decisions in which various district courts followed the law as
 9 the mere exercise of discretion in which each court coincidentally “chose” to apply collateral
 10 estoppel. *See* Finjan’s Opposition at 5. The more accurate way to describe those decisions is that
 11 the district courts followed the law, so as to avoid error. And to be clear, Finjan does not cite any
 12 Federal Circuit case stating that a district court has the discretion to not apply collateral estoppel to
 13 an *invalidity* ruling where the four-part test for collateral estoppel is satisfied, which would be
 14 irreconcilable with *Mendenhall*. 26 F.3d 1573 at 1579-80.

15 Finally, Finjan’s argument that the ESET Order is not final because it was not “sufficiently
 16 heard” fails as a matter of law. The ESET Order satisfies the requirement of a “final judgment”
 17 under Ninth Circuit law, and, the arguments that Finjan will make on appeal and that Finjan is
 18 making to the ESET Court in its motion for reconsideration are irrelevant. Under Ninth Circuit
 19 law, a decision is “sufficiently firm” even if not yet ripe for appeal. *Abbott Diabetes Care Inc. v.*
 20 *Roche Diagnostics Corp.*, C04-02123MJJ, 2007 WL 1239220, at *12 (N.D. Cal. Apr. 27, 2007).
 21 The same is true even if there is a pending appeal, in which issues will be considered de novo.
 22 *Gonzalez v. Tagged, Inc.*, 16-cv-00574-YGR, 2016 WL 3257734, at *2 (N.D. Cal. June 14, 2016).
 23 In light of these principles, the pendency of a motion for reconsideration – an “extraordinary
 24 remedy, to be used sparingly,” *Kona Enters., Inc. v. Estate of Bishop*, 229 F.3d 877, 890 (9th Cir.
 25 2000) – cannot alter the analysis. Indeed, over two weeks after Finjan filed its motion for
 26 reconsideration, the docket reflects that Judge Bencivengo has not even requested further briefing.
 27 *Finjan, Inc. v. ESET, LLC*, Case No. 3:17-cv-0183-CAB-BGS.

At a minimum, the patents that all present the “same issue” that is the basis for the ESET Order – the ‘844 Patent, ‘780 Patent and ‘494 Patent – should be severed and stayed immediately to avoid forcing Cisco to spend money preparing for trial.

Dated: April 29, 2021

Respectfully Submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the above and foregoing document has been served on April 29, 2021 to all counsel of record who are deemed to have consented to electronic service via the Court's CM/ECF system.

/s/ Matthew C. Gaudet
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